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IN THE

Supreme Court of the United States

KIMBERLY-CLARK CORPORATION,
Petitioner,
v.
TYCO INTERNATIONAL (US), INC.,
THE KENDALL COMPANY, INBRAND CORPORATION,
AND CONFAB, INC.
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether a court construing the claims of a patent errs by reading a limitation into the claims based upon language in the patent's written description which does not set forth the supposed limitation with reasonable clarity, deliberateness, and precision.

2. Whether language in a patent claim that was copied from another patent in an interference proceeding under 35 U.S.C. § 135 may be given a construction substantially narrower than the original claim.

PARTIES TO THE PROCEEDING

All parties to the proceeding are listed in the caption of the case.

Petitioner Kimberly-Clark Corporation is a publicly held corporation. It has no parent corporation, and no publicly held corporation owns 10 percent or more of its stock.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Kimberly-Clark Corporation ("Kimberly-Clark") respectfully requests that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit is included in the Appendix ("App.") at pages 1a-10a; it is not officially reported but can be found at *Kimberly-Clark Corp.* v. *Tyco International (US), Inc.*, No. 00-1080, 2001 WL 170461 (Fed. Cir. Feb. 20, 2001). The order of the court of appeals denying Kimberly-Clark's petition for rehearing and rehearing *en banc* is unreported and is included at App. 69a. The United States District Court for the Western District of Wisconsin issued two opinions in this matter. The district court's opinion denying both parties' motions for partial summary judgment is unreported and is included at App. 40a-68a. The district court's *Markman* ruling, see generally *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967, 980-81 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996), is also unreported and is included at App. 12a-39a. The district court's order entering judgment is unreported and is included at App. 11a.

JURISDICTION

The court of appeals entered its opinion and judgment on February 20, 2001. The court of appeals denied Kimberly-Clark's timely petition for rehearing and rehearing *en banc* on April 20, 2001. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

35 U.S.C. § 112 provides, in pertinent part:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
>
> A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

> Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

* * *

35 U.S.C. § 120 provides:

> An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

STATEMENT OF THE CASE

In its decision in this case, the Federal Circuit abandoned long-settled principles governing the construction of patent claims. Those principles are the basis upon which patent holders, their licensees and competitors, and the public determine which areas of technology are freely available and which are restricted by the patent monopoly. Because the Federal Circuit's decision creates substantial uncertainty in an area of the law that is of vital and ever-increasing importance to the nation's economy, Kimberly-Clark petitions for review of that decision.

The basic question presented to and decided by the lower courts in this case was whether broad and unqualified language in the claims of a patent can be narrowly circumscribed by limitations drawn from the patent's written description. The district court and court of appeals ignored the broad claim language of the patents at issue here and inserted into the claims a narrow limitation derived from isolated portions of the patents' written descriptions and prosecution histories. By departing from the most basic principles of claim construction in this fashion, the Federal Circuit has undermined the certainty and predictability that are essential to the technological innovation and development that the patent laws are designed to promote.

I. THE INVENTION

Kimberly-Clark filed suit in 1998 alleging infringement of three patents issued to Kenneth M. Enloe and assigned to Kimberly-Clark: U.S. Patent No. 4,704,116 ("Enloe I"), U.S. Patent No. 5,415,644 ("Enloe II"), and U.S. Patent No. 5,599,338 ("Enloe III"). Enloe's basic invention, which is the subject of these three patents, is an improvement to the design of disposable diapers, specifically the addition of a pair of elasticized inner flaps.

In general, disposable diapers are constructed with an absorbent core made from wood pulp fluff and superabsorbent material. Covering the absorbent core, on the side of the diaper that touches the baby, is the topsheet (or bodyside liner). The topsheet is made from a material that allows liquid to pass through and into the absorbent core. (JA96 (col. 4, lns. 31-36); JA2413 (col. 5, ln. 3-col. 6, ln. 9).)[1] The outside of the diaper is commonly covered by a layer of plastic film, referred to as the backsheet. The backsheet helps prevent liquid in the absorbent core from escaping the diaper.

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[1] The relevant record materials are contained in the Joint Appendix filed in the court of appeals and are cited as "JA__."

(JA96 (col. 4, lns. 35-36); JA2413 (col. 6, ln. 42-col. 7, ln. 2).) Also, to help prevent liquid from escaping the diaper, manufacturers place elastics around the leg openings to form "gaskets" to reduce leakage around the baby's legs. (JA97 (col. 5, lns. 4-15); JA2414 (col. 7, ln. 28-col. 8, ln. 58).)

Although conventional disposable diapers incorporated a variety of elements to attempt to prevent leakage, leakage was nevertheless still a significant problem as recently as the early 1980s. (JA1659.) To address this problem, Enloe, an experienced scientist at Kimberly-Clark, in 1982 conceived the idea of adding stand-up elasticized flaps, inboard of the elasticized leg openings of a diaper. (JA1667-68.) (The inner flap feature goes by a variety of names, including "barrier cuffs" and "inner leg cuffs.") The flaps, which are shown at numbers 30 and 32 in Figure 2 of the Enloe I patent below (JA89), help to prevent leakage.

[Figure 2]

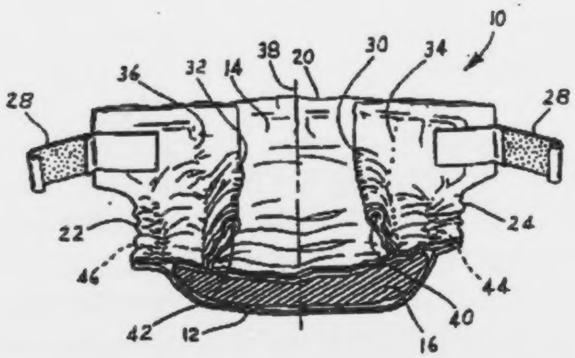

FIG. 2

From the outset, Enloe contemplated making his inner flaps from either fluid pervious or fluid impervious materials, although he preferred fluid pervious materials. Enloe made this clear in an Invention Disclosure that he sent to the Kimberly-Clark Patent Department on May 10, 1982, in which he described his inner flap material by explaining that although "liquid impervious material or laminate could be used . . . a porous, fine mesh material . . . should provide enhanced comfort." (JA1667.)

Testing revealed that the addition of inner flaps to disposable diapers reduced leakage to an extent far beyond what would have been expected. (JA1661.) Today, Enloe's inner flap invention is widely licensed to and employed by most other manufacturers in the disposable diaper industry. (JA168-69.)

II. PROSECUTION OF THE ENLOE PATENTS

A. Enloe I

Enloe filed his initial patent application on July 2, 1984. From the outset, Enloe asserted inventorship rights over a disposable diaper with leg elastics and inner flaps, regardless of whether those flaps were fluid pervious or impervious. Claim 1 of the initial application reflected this view and claimed a diaper without any limitation on the material used to form the inner flaps. (JA2875.) Claim 2, by contrast, expressly limited the flap material, claiming "[t]he diaper of Claim 1 wherein the flap is fluid permeable." (*Id.*) The written description of the invention in this application noted Enloe's preference concerning the flap material, stating that the "flap material is *preferably* soft, conformable and vapor and/or fluid permeable." (JA2874 (emphasis added).) Both this description and Claims 1 and 2 made clear that Enloe sought to claim diapers constructed with inner flaps of either fluid pervious or fluid impervious material.

In April 1985, the patent examiner rejected all of the claims of this application, deciding that Claims 1 and 2 were anticipated by a prior patent to Beckestrom. (JA2885.) The Beckestrom patent (JA2498-503) disclosed a diaper with elasticized side flaps that, unlike the inner flaps in the Enloe invention, were attached to the side edges of the diaper and thus functioned as leg elastics. The Beckestrom flaps were made using, as one layer, an extension of the plastic backsheet and were thus impermeable to liquid. (JA2502 (col. 2, lns. 31-35).)

In response to the rejection, Enloe filed a continuation-in-part ("CIP") application, which allowed him to maintain the benefit of the July 2, 1984 filing date of his original, or "parent," application. Consistent with Enloe's view that he had invented a disposable diaper with inner flaps, whether fluid pervious or not, the CIP application identified fluid pervious material as the *preferred*, but not only, material for the inner flaps. (JA2932.) The CIP application also explained why Enloe's preferred configuration was a better solution to the leakage problem than the Beckestrom design:

> However, these attempts to solve one problem have resulted in the emergence of other problems. For example, the elasticized flaps can cause the waterproof material of the flaps to provide a tight seal at the thigh crease because the tensioned elastic presses the easily deformable flaps into close contact with the skin. The waterproof material of the flaps can then cause urine or moisture and even liquid fece material to collect next to the skin and cause skin irritation.
>
> The present application teaches an improved disposable garment which provides fluid pervious flaps to enhance the containment and absorption of urine and other fluid exudates as well as solid exudates. The flaps, made up of water pervious material, slows the sideways flow of fluidic material and stops essentially all the sideways flow of solid material. Furthermore, the flaps enhance skin dryness by causing at least one extra layer of material to be disposed between the absorbent area of the diaper and the skin of the wearer. This, in addition to having fecal material separated from the skin by at least one layer of flap material, decreases the potential of skin irritation.

(JA2926-27.) Notwithstanding Enloe's identification in his written description of fluid pervious material as the "preferred," but not exclusive, material for the inner flaps, the claims of his CIP application were expressly limited to disposable diapers with "fluid pervious flaps." (JA2936.) After the claims were amended to require leg elastics, which had been included in the parent application but initially dropped from the claims of the CIP application, the examiner allowed the amended claims, and the Enloe I patent issued on November 3, 1987. (JA84-100.)

B. Enloe II

Shortly before Enloe I issued, the Patent and Trademark Office ("PTO") issued U.S. Patent No. 4,695,278 to Michael Lawson, who assigned the patent to The Procter & Gamble Company ("P&G"). (JA2407-18.) The Lawson patent claimed what Enloe had invented: a diaper with leg elastics and inner flaps. The broadest claims of the Lawson patent claimed inner flaps (called "barrier cuffs" in the Lawson patent) without limitation as to perviousness or imperviousness. (JA2417 (col. 14, lns. 30-34).) The Lawson patent also included dependent claims that required the inner flaps to be "liquid impermeable." (JA2418 (col. 15, lns. 35-36).)

In response to the issuance of the Lawson patent, Kimberly-Clark sued P&G, asking a district court to invalidate the Lawson patent pursuant to 35 U.S.C. § 291.[2] Kimberly-Clark also provoked an interference in the PTO with the Lawson patent. See generally *General Instrument Corp.* v. *Scientific-Atlanta, Inc.*, 995 F.2d 209, 211-12 (Fed. Cir. 1993) (providing an overview of interference proceedings). As a result of the section 291 action, the district court found that Enloe made his invention before Lawson and was thus entitled to priority. (JA715.) The Federal Circuit affirmed this finding in *Kimberly-Clark Corp.* v. *Procter & Gamble Distributing Co.*, 973 F.2d 911, 914-15 (Fed. Cir. 1992).

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[2] Kimberly-Clark also brought an infringement claim against P&G, but that claim became moot after Kimberly-Clark and P&G exchanged non-exclusive immunities from suit under their respective patents.

The interference proceeding in the PTO concluded with a similar result. As is standard in interference proceedings, Kimberly-Clark provoked the interference by copying into a pending Enloe continuation application certain claims from the Lawson patent. (JA3585-90.) The "Count" in the interference, which describes the disputed invention, 37 C.F.R. § 1.601(f), thus was identical to Claim 1 of the Lawson patent, and claimed a disposable absorbent article that, in relevant part, included:

> a barrier cuff having a proximal edge and a distal edge, said barrier cuff disposed inboard of said gasketing cuff.

(JA3582.) This claim did not limit the material employed to make the flaps, or barrier cuffs, to either pervious or impervious materials.

The Board of Patent Appeals and Interferences (the "Board") normally identifies claims that "correspond" to the Count, meaning that they involve the same invention as the Count or would have been obvious from the Count. The Board initially identified 19 claims of the Lawson patent that corresponded to the Count, but did not include the Lawson claims expressly limited to diapers with liquid impermeable flaps. (JA3582.) Enloe accordingly filed a preliminary motion to add those Lawson claims to the interference. (JA2094-97.) The Board denied this motion for reasons unrelated to whether Enloe's pending application supported a generic claim to diapers with flaps and declined to rule on whether the application would support claims limited to fluid impervious flaps. (JA2103.) In other words, the Board made clear that it was taking no position on whether Enloe could properly seek claims that were limited to fluid impervious flaps, as distinct from the generic claim simply to flaps, which was at issue in the interference.

In August 1992, the Board resolved the interference in Enloe's favor, finding that Enloe had invented before Lawson. Consequently, the Lawson claims that corresponded to the Count were canceled (JA2466), and Enloe resumed prosecution of the application that contained the claims copied from the Lawson patent – *i.e.*, claims to diapers with leg elastics and "barrier cuffs," without regard to perviousness or imperviousness. While the claims were pending in the PTO, the examiner suggested to Enloe, "without reference to patentability of the other claims now pending," that claims limited to fluid permeable barrier cuffs might be patentable. (JA3803.) Enloe responded to this suggestion by adding a new claim that called for inner flaps that would permit moisture to escape. (JA3802.) That claim ultimately became Claim 26 of the Enloe II patent. Enloe did not, at this or any other time during the prosecution of this application, cancel or amend his broad claims that were not so limited. The Enloe II patent thus issued on May 16, 1995, with its broadest claims, in contrast to Enloe I, encompassing inner flaps, or "barrier cuffs," without regard to perviousness.

C. Enloe III

Before the Enloe II patent issued, Enloe filed a further continuation application, which he continued to prosecute after he obtained the Enloe II patent. (JA4771-92.) The Enloe III patent issued from this application in February 1997. (JA118.) Like Enloe II, it claimed a disposable diaper with leg elastics and barrier cuffs (inner flaps), without limitation as to perviousness or imperviousness. (JA130 (col. 7, lns. 10-29).)

III. PROCEEDINGS BELOW

Kimberly-Clark filed its complaint in October 1998, accusing defendants of infringing all three Enloe patents. The defendants denied infringement and asserted that the Enloe patents were invalid. In June 1999, both sides moved for partial summary judgment on infringement. Although a

Markman hearing had been set for September 15, 1999, the district court denied the summary judgment motions on September 9, 1999. App. 40a-68a. In its order, the district court ruled on four claim construction issues, including the issue that gives rise to this Petition. Specifically, the court ruled that, like the claims of the Enloe I patent, all of the Enloe II and Enloe III patent claims are limited to diapers with fluid pervious inner flaps, even though the broad claims of those patents contain no such limitation. *Id.* at 63a-65a; see also *id.* at 23a-24a.

After conducting a *Markman* hearing, the district court issued another decision on November 1, 1999. App. 12a-39a. In this decision, the district court reversed three of the four claim construction rulings in its September 9 order, but continued to hold that all of the Enloe II and Enloe III patent claims were limited to diapers with fluid pervious inner flaps. *Id.* at 29a. Under the claim construction finally adopted by the district court, Kimberly-Clark agreed that no disputed issue of material fact remained with respect to infringement, and judgment was entered for the defendants on November 3, 1999. *Id.* at 11a.

Reviewing the district court's claim construction rulings *de novo*, see *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996), the Federal Circuit affirmed the judgment in an unpublished opinion. App. 1a-10a. Rather than following the settled practice of beginning its claim construction analysis with the text of the claims themselves, the court began its analysis by considering what weight to give to portions of the patents' written descriptions. *Id.* at 5a-7a. The court seized on the two paragraphs, quoted above, in which Enloe explained why his preferred embodiment was superior to the invention claimed in the Beckestrom patent. Although the court recognized that the written descriptions of Enloe II and Enloe III contained other language indicating that "liquid pervious" was only a preferred characteristic and not an essential one, see *id.* at 6a (noting that the patent specifications state that the "'preferred material for the flaps . . . is a liquid pervious material'") (omission in original), the court concluded that this language should be given little weight because it was inserted, in the court's terms, "perhaps by mistake." *Id.*

The court next considered the prosecution history. The court noted that the written descriptions of the Enloe I, Enloe II, and Enloe III patents all contain the same two paragraphs discussing the Beckestrom patent. Although the Enloe I *claim* language differed from that in Enloe II and Enloe III, the court concluded that this difference in claim language had no effect on the scope of the inventions because these two background paragraphs had been carried over from the written description of the Enloe I patent to the Enloe II and Enloe III patents. The court also relied on the fact that, during the Lawson interference proceeding, the Board of Patent Appeals and Interferences had denied Kimberly-Clark's motion to add various Lawson claims to the Count. Without considering the stated reasons for the Board's ruling, the panel concluded that the Board "understood that Enloe had disclaimed fluid impervious flaps notwithstanding the omission of the express references to fluid pervious flaps." App. 7a. Employing a peculiar definition of the adverb "expressly," the court concluded that "Enloe II and Enloe III cannot be correctly construed to cover what was expressly disclaimed." *Id.* at 8a.

Although the court noted that Enloe, by copying the Lawson claims to provoke the interference, had deleted the limiting "fluid pervious" language that had originated in the claims of Enloe I, see App. 7a, the court did not look to the Lawson patent to guide its claim construction analysis. The court failed to acknowledge the clear precedent that required that claim language copied from another patent in an interference proceeding be given the same meaning in the new patent that it had in the original.

REASONS FOR GRANTING THE PETITION

The Federal Circuit's decision in this case undermines the most fundamental principles governing the construction of patent claims. First, the decision demotes claim language from its proper position as the primary and controlling determinant of the meaning of patent claims and deploys in its place a selective and arbitrary review of the written description and prosecution history which eliminates any semblance of certainty or predictability in the claim construction process. By doing so, the decision creates uncertainty in the preparation and prosecution of patent applications and cripples the ability of competitors and the public to interpret issued patents. That, in turn, will necessarily hamper innovation in all areas of technology. In addition to its impact on future inventions and patents, the court's fundamental change in the rules of claim construction distorts the value of bargains struck in scores of assignments, licensing agreements, and other transactions based upon what were previously understood to be clear and settled patent rights.

Second, and of equal significance, if specification language discussing a preferred embodiment is employed to narrow broad claim language, as was done here, future patent applicants will undoubtedly minimize any discussion of preferred embodiments in their patent specifications. Such a mischievous disincentive will substantially undercut the important role that patent disclosures play in disseminating information concerning not only the specific patented invention, but the general field of technological endeavor as well. This Court has long recognized the patent system's delicate balance between the grant of exclusive property rights and public disclosure of new technological developments. See, *e.g.*, *Kewanee Oil Co.* v. *Bicron Corp.*, 416 U.S. 470, 480 (1974); *United States* v. *Dubilier Condenser Corp.*, 289 U.S. 178, 186-87 (1933). Rules or principles of patent interpretation – judicially created or otherwise – that discourage the disclosure of the "best mode contemplated by the inventor of carrying out his invention," 35 U.S.C. § 112, upset that balance. The Federal Circuit's decision in this case does exactly that. The perverse incentive created by the decision will drive information away from the public domain rather than into it.

1. The Federal Circuit's decision unsettles expectations established by the previously consistent application of several fundamental claim construction principles. Most significantly, the court failed to recognize the primacy of claim language in the claim construction process. *K-2 Corp.* v. *Salomon S.A.*, 191 F.3d 1356, 1363-65 (Fed. Cir. 1999). It also failed to follow the settled canon of claim construction that "[g]eneral descriptive terms [are to] ordinarily be given their full meaning; modifiers [are] not to be added [to] broad terms standing alone." *Johnson Worldwide Assocs., Inc.* v. *Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999). And it substantially eroded the previously unquestioned rule that courts do not narrow broad claim language with limitations drawn from the specification unless the restriction is set forth in the specification "with reasonable clarity, deliberateness, and precision." *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

It was not error for the court of appeals to consider the specification and the prosecution history in determining the meaning of the patents' claims. See, *e.g.*, *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc) (stating that "[t]he claims, the specification, and the prosecution history" are three sources to consider in ascertaining the meaning of claims), *aff'd*, 517 U.S. 370 (1996). The court's error came in its failure to accord the claim language its preeminent role among these sources and its failure to relegate the specification and the prosecution history to their appropriate subordinate roles:

> The written description part of the specification itself does not delimit the right to exclude. That is the

> function and purpose of claims. . . . Although the prosecution history can and should be used to understand the language used in the claims, it too cannot enlarge, diminish, or vary the limitations in the claims.

Id. at 980 (internal quotation marks omitted).[3] In this case, the relevant claims contain absolutely no limitation on the type of material that can be used to form the flaps. But the Federal Circuit created such a limitation based upon its understanding of, at best, ambiguous language in the written description and a prosecution history in which Enloe copied claims verbatim from a patent that included no restriction on the flaps.

If this case involved a question of statutory interpretation, the error of the court below would be self-evident. The court's focus was not on the plain language in the claims; instead, the court turned to secondary sources of information and used them to add limitations that simply were not present in the claims themselves. Just as courts are not free to disregard the plain language of a statute in reliance upon rules of construction or legislative history, the Federal Circuit is not free to rewrite patent claims – years after the fact – based on prosecution histories and specifications. At a minimum, the Court should review this case to decide what methodology to use in claim construction.

Nothing in the broad claim language here called for resort to the written description to narrow the claims. Such an invitation from the text of a claim is an established prerequisite to narrowing claim language on the basis of the written description:

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[3] *See also Digital Biometrics, Inc.* v. *Identix, Inc.*, 149 F.3d 1335, 1344 (Fed. Cir. 1998) ("[T]here is a hierarchy of analytical tools [to use in the claim construction process]. The actual words of the claim are the controlling focus."); *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

> In short, a court must presume that the terms in the claim mean what they say, and, unless otherwise compelled, give full effect to the ordinary and accustomed meaning of claim terms.
>
> In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements. That is, claim terms cannot be narrowed by reference to the written description or prosecution history unless the language of the claims invites reference to those sources. In other words, there must be a textual reference in the actual language of the claim with which to associate a proffered claim construction.

Johnson Worldwide Assocs., 175 F.3d at 989-90 (internal quotation marks and citations omitted) (citing *McCarthy* v. *Lehigh Valley R.R.*, 160 U.S. 110, 116 (1895)); *id.* at 990 ("'[I]f we once begin to include elements not mentioned in the claim in order to limit such claim . . . , we should never know where to stop.'")) (alteration and omission in original) (quoting *McCarthy*, 160 U.S. at 116). The court in this case neither looked for nor found any invitation in the language of the claims before resorting to the written description and prosecution history as a source of claim limitations. Indeed, the court's opinion gives no indication that the court gave *any* weight to the claim language. Never before has broad claim language been circumscribed with so little support from the specification and prosecution history and so little regard for the claim language itself. The court's utter disregard for the language of the claims flies in the face of decades of claim construction practice and precedent.

As if to reinforce its decision to brush aside the claim language, the court also refused to apply the logically coherent and well-established doctrine of claim differentiation. App. 7a-8a. Under this doctrine, independent claims within the same patent are presumed to have different scopes. See *Tandon Corp.* v. *United States Int'l Trade Comm'n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987). Claim 26 of the Enloe II patent is an independent claim and specifically claims diapers that contain, *inter alia*, fluid pervious flaps. Under settled principles, then, Claim 1 of the Enloe II patent is presumed to have a different scope than Claim 26. But the court of appeals dismissed this reasoning out of hand and adopted a claim construction that rendered an independent claim of an issued patent entirely superfluous. App. 8a.

At the core of its reasoning, the panel's decision rests on an over-reliance upon and misunderstanding of the prosecution history. Just as the Federal Circuit relied upon the amendment of a claim element, regardless of the context or reason for the amendment, to preclude all claims of infringement under the doctrine of equivalents in *Festo Corp.* v. *Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000), *cert. granted*, 69 U.S.L.W. 3775 (U.S. June 19, 2001) (No. 00-1543), so too here the court seized upon Enloe's decision to narrow the claims of Enloe I in response to a rejection based on the Beckestrom patent to preclude any subsequent effort by Enloe, regardless of the language of subsequently allowed claims, to patent his invention of a disposable diaper with leg elastics and inner flaps. The court added the "fluid pervious" limitation to the claims because it held as a matter of law that Enloe's amendment forever abandoned his broad claim to the addition of inner flaps, whether fluid pervious or fluid impervious. Contrary to the court's reasoning, however, Enloe did not abandon the effort to obtain protection for his full invention, but rather did precisely what the statute permitted him to do: he pursued additional patents based upon the disclosure in his original application of the full scope of his invention. See 35 U.S.C. § 120 (later application has the benefit of earlier filing date if the earlier application disclosed the invention).

Against this prosecution history, the court of appeals relied exclusively on the fact that the specifications of all three patents contain language, originally inserted to address the Enloe I Examiner's citation of the Beckestrom patent, that "'[t]he present application teaches an improved disposable garment which provides fluid pervious flaps.'" App. 6a (alteration in original). Given that this language originated with the prosecution of Enloe I, the claims of which were limited to diapers with pervious flaps, and that Enloe's preferred embodiment in all three patents included pervious flaps, this language cannot be interpreted as a disclaimer of impervious flaps. Indeed, as the Federal Circuit has recognized in the past, where several patents emerge from the same parent application, it is "unsurprising" that passages in the specifications may be relevant to some but not all of the patents. See *Pitney Bowes, Inc.* v. *Hewlett-Packard Co.*, 182 F.3d 1298, 1310-11 (Fed. Cir. 1999). Moreover, as the court noted, the specifications also state that the "'preferred material for the flaps . . . is a liquid pervious material.'" App. 6a (omission in original). The court, however, clearly undermined the policy against narrowing broad claim language in the absence of a clear, deliberate intent to do so, see *In re Paulsen*, 30 F.3d at 1480, by dismissing as a "mistake" this language in the specification which so clearly supported a broad construction of the broad claim language. App. 6a.

The court of appeals' decision to ignore clear claim language, to embrace an isolated portion of the prosecution history without regard for its context, and to dismiss as a mistake specification language that is entirely consistent with the broad claim language scrambles the well-established process of claim construction. The Federal Circuit's decision, if not corrected, renders claim construction an uncertain, unpredictable exercise and will substantially undercut the promotion of science and technology, which the patent laws are designed to foster.

2. The Federal Circuit's decision conflicts with another clear principle of claim construction: "When interpretation is required of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent from which it was copied." *In re Spina*, 975 F.2d 854, 856 (Fed. Cir. 1992). Although Kimberly-Clark argued in its opening brief before the Federal Circuit that the court should follow *Spina* and look to the Lawson patent from which the claims of Enloe II were copied, the court failed even to mention – much less distinguish – *Spina* in any way.[4]

Had the court conducted the *Spina* inquiry, it would have found that the Lawson patent leaves no doubt that its broad claim language covers fluid impervious flaps. As with Enloe II and Enloe III, the claim language – requiring "a barrier cuff," without qualification – by its terms covers inner flaps, regardless of perviousness. Moreover, several of Lawson's dependent claims are specifically limited to fluid impervious flaps. Because an independent claim necessarily must be broad enough to encompass its dependent claims, *Robotic Vision Sys., Inc.* v. *View Eng'g, Inc.*, 189 F.3d 1370, 1376 (Fed. Cir. 1999), Lawson's dependent claims limited to fluid impervious flaps demand a reading of Lawson's independent claim – and the Enloe II claim copied from it – that includes impervious flaps.[5]

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[4] This is thus not a case like *Cultor Corp* v. *A.E. Staley Manufacturing. Co.*, 224 F.3d 1328 (Fed. Cir. 2000), in which the court considered the *Spina* rule but deemed it overridden where the inventor's own specification expressly disclaimed the construction supported by the patent from which the claims had been copied. *Id.* at 1332. Here, in contrast, Enloe's specification was completely consistent with the broad construction of "barrier cuffs" dictated by the Lawson patent.

[5] Further evidencing the broad scope of the Lawson claims, the Lawson specification identifies fluid impervious flaps as Lawson's preferred embodiment. A patent's claims should not be construed in a manner that excludes the preferred embodiment from their scope. *See Vitronics Corp.* v. *Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) (construing

Instead of engaging in this analysis, the court drew the superficial inference that the Examiner and the Board of Patent Appeals "understood that Enloe had disclaimed fluid impervious flaps." App. 7a. Had the court actually considered the Board's reasoning, however, it could not avoid concluding that the Board specifically declined to rule on whether Enloe had support in his application for claims limited to fluid impervious flaps. The court also would have realized that the issue before it was not whether Claim 1 of Enloe II and Claim 1 of Enloe III were limited to diapers with fluid impervious flaps, for no one claimed that they were. The issue was whether Enloe's claims covered inner flaps in general, without regard to perviousness. The Federal Circuit's superficial analysis of the interference, and its failure to apply *Spina*, represent a further break with claim construction precedent. By divorcing claim construction from both the language of the claim and the patent in which that claim language had its origins, the Federal Circuit's decision further erodes the consistency and predictability in claim construction that is essential to the patent system.

* * * *

In its decision in this case, the court of appeals has done serious violence to the process of claim construction in two fundamental respects. First, it has made the plain language of claims no longer the critical element of construction. Claim language has been placed on an even par with the written descriptions, rules of construction, and prosecution history in a way that will create serious confusion and upset settled licensing and other agreements among patent holders and those who seek to use their patents. Second, the decision undermines a common-sense rule of construction about how to interpret identical language in separate applications and creates unwarranted confusion by allowing the same language

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claim to exclude preferred embodiment "is rarely, if ever, correct and would require highly persuasive evidentiary support").

to be subject to differing interpretations. Again, this approach can only distort claim construction in a way that ultimately does harm to the underlying goals of the patent system. This Court has heretofore been vigilant in ensuring that the process of enforcing patent rights must remain fair and rational. See *Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370 (1996); *Warner-Jenkinson Co.* v. *Hilton Davis Chem. Co.*, 520 U.S. 17 (1997); *Festo Corp.* v. *Shoketsu Kinzoku Kogyo Kabushiki Co.*, 69 U.S.L.W. 3775 (U.S. June 19, 2001) (No. 00-1543) (cert. granted). This Court's intervention is necessary again.

CONCLUSION

The petition for writ of certiorari should be granted.

Respectfully submitted,

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July 16, 2001

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APPENDICES

APPENDIX A

UNITED STATES COURT OF APPEALS
FEDERAL CIRCUIT

No. 00-1080

KIMBERLY-CLARK CORPORATION,
Plaintiff-Appellant,
v.
TYCO INTERNATIONAL (US), INC.,
THE KENDALL COMPANY,
INBRAND CORPORATION AND CONFAB, INC.,
Defendants-Appellees.

DECIDED: February 20, 2001

Before MICHEL, LOURIE, and BRYSON, *Circuit Judges.*

BRYSON, *Circuit Judge.*

Kimberly-Clark Corporation owns three U.S. patents directed to diapers with elasticized side pockets, U.S. Patent Nos. 4,704,116 (Enloe I), 5,415,644 (Enloe II), and 5,599,338 (Enloe III). Kimberly-Clark brought suit against Tyco International (US), Inc., the Kendall Company, Inbrand Corporation, and Confab, Inc., (collectively, Tyco) in the United States District Court for the Western District of Wisconsin, asserting infringement of all three patents. After the district court construed the claims, the parties advised the court that under the court's claim construction Tyco did not infringe. The court therefore entered judgment in favor of Tyco, and Kimberly-Clark appealed. Because the district court correctly construed the claims in all three patents to be limited to "fluid pervious flaps," we *affirm.*

BACKGROUND

All three Enloe patents describe an improved design for disposable diapers. Disposable diapers typically include a backsheet, a bodyside liner, and an absorbent body or pad disposed between the backsheet and the bodyside liner. Enloe I, col. 4, ll. 31-34. The bodyside liner is made of a liquid pervious material, while the backsheet is made of a liquid impervious material. Enloe I, col. 4, ll. 34-36. Enloe proposed adding a pair of flaps attached to or formed from the bodyside liner. These inner flaps form pockets into which solid fecal material collects and is contained. Enloe I, col. 4, ll. 63-64. They may also serve to strain fluidic fecal material, allowing the liquid portions to be absorbed by the absorbent body or pad. Enloe I, col. 4, ll. 65-68. The inner flaps, 30 and 32, are shown in Figure 2, a cross-sectional view of the improved diaper:

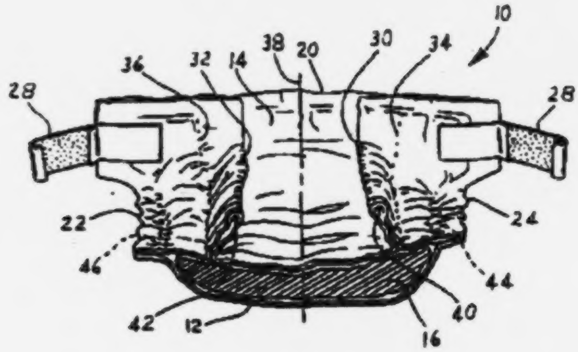

FIG. 2

The present dispute concerns the material of the inner flaps. In Enloe's original patent application, the inner flaps could be made from either fluid pervious or fluid impervious material. The written description provided that the "flap material is preferably soft, comfortable and vapor and/or fluid permeable," but did not otherwise limit Enloe's claims. Independent claim 1 generally recited "[a] unitary diaper having . . . two flaps extending toward each end," while dependent claim 2 recited the "diaper of Claim 1 wherein the flap is fluid permeable." Those claims and others were rejected by the examiner as anticipated by a United States patent to Beckestrom. Rather than challenge the rejection, Enloe abandoned his original application and filed a continuation-in-part.

In the continuation-in-part, Enloe revised the written description to distinguish the Beckestrom reference on the ground that the prior art flaps—unlike his flaps—were fluid impervious or waterproof:

> However, these attempts [by Beckestrom] to solve one problem have resulted in the emergence of other problems. For example, the elasticized flaps can cause the *waterproof material of the flaps* to provide a tight seal at the thigh crease because the tensioned elastic presses the easily deformable flaps into close contact with the skin. The *waterproof material of the flaps* can then cause urine or moisture and even liquid fece material to collect next to the skin and cause skin irritation.
>
> The present application teaches an improved disposable garment which provides *fluid pervious flaps* to enhance the containment and absorption of urine and other fluid exudates as well as solid exudates. The *flaps, made up of water pervious material*, slows [sic] the sideways flow of solid material. Furthermore, the flaps enhance skin dryness by causing at least one extra layer of material to be disposed between the absorbent area of the diaper and the skin of the wearer. This, in addition to having fecal material separated from the skin by at least one layer of flap material, decreases the potential of skin irritation.

The revised written description further provided (consistent with the original application) that the "preferred material for flaps 30, 32 is a liquid pervious material." Enloe's new claims were also explicitly limited to "fluid pervious flaps." This continuation-in-part became Enloe I.

Claim 1 of Enloe I specifies a fluid pervious material:

> 1. An absorbent garment comprising:
>
> a back sheet;
>
> a liquid pervious bodyside liner, essentially coterminous with said back sheet, defining front and back waist sections and opposed front and second sides connecting said waist sections, including a pair of leg sections delimited along said sides, each of said leg sections having a tensioned elastic member disposed between said liner and back sheet; and
>
> first and second elasticized *fluid pervious flaps*, attached to or formed from said bodyside liner and spaced inwardly of said leg elastic members, respectively, defining a waste containment pocket.

Enloe I, cl. 1 (emphasis added). In allowing this and other Enloe I claims, the examiner noted that the "necessity of a fluid permeable flap" in combination with elastic in the flap and at the leg openings "overcomes the prior art."

The written description for Enloe I became the basis for both Enloe II and Enloe III. In particular, Enloe continued to include in the written description the same language from Enloe I that distinguished Beckestrom on the ground that Beckestrom's prior art flaps were fluid impervious. *See* Enloe II, col. 2, ll. 38-59; Enloe III, col. 2, ll. 35-54. During the prosecution of Enloe II and Enloe III, Enloe never sought to remove or amend that language, nor to traverse, appeal, or submit arguments seeking to overcome the initial rejection on other grounds.

The allowed claims of Enloe II and Enloe III—unlike those of Enloe I—do not explicitly recite a "fluid pervious" limitation. Although Enloe initially included such a limitation in the Enloe II application claims, he later amended those claims to remove the "fluid pervious" limitation. That amendment was made after the PTO declared an interference with a United States patent to Lawson. At that time, Enloe amended his claims to copy those of the Lawson patent, which had the effect of omitting the explicit "fluid pervious" limitation from his claims. Despite the seemingly broad language of the amended claims and the interference count, however, the PTO did not designate claims in the Lawson patent that were specifically directed to fluid impervious flaps as corresponding to the count. Enloe challenged that determination, filing a motion to amend the count to add the fluid impervious claims from Lawson. The Board of Patent Appeals and Interferences denied Enloe's motion, finding that those claims were not anticipated by the count and that Enloe had failed to show that they were obvious in view of the count. Enloe prevailed in the interference and continued to prosecute the claims in their amended form.

DISCUSSION

A. Kimberly-Clark does not dispute that the claims of Enloe I are limited to fluid pervious flaps, but contends that the claims of Enloe II and Enloe III are not subject to that limitation. Although the specifications of Enloe II and Enloe III are identical to the specification of Enloe I in pertinent part, each referring to the flaps as fluid pervious, Kimberly-Clark asserts that the specifications of Enloe II and Enloe III should not be interpreted to limit the broad language of the claims of those patents, which are not expressly limited to fluid pervious flaps.

We agree with the district court that the specifications of Enloe II and Enloe III clearly disclaim fluid impervious flaps, and that the asserted claims of Enloe II and Enloe III must be read to give effect to that disclaimer. Enloe chose to distinguish the prior art Beckestrom reference in each specification by noting the inadequacies of fluid impervious flaps and touting the advantages of fluid pervious flaps. The specifications unambiguously state that "[t]he present application teaches an improved disposable garment which provides fluid pervious flaps." That language from the specifications provides strong support for the district court's conclusion that the asserted claims of Enloe II and Enloe III must be read as limited to fluid pervious flaps. *See Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159, 47 USPQ2d 1829, 1833 (Fed. Cir. 1998) (written description did not support claim covering conical and non-conical shaped cups where the specification "specifically distinguishes the prior art [non-conical shape cups] as inferior and touts the advantages of the conical shape of the [patented cup]"); *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1581, 42 USPQ2d 1777, 1781 (Fed. Cir. 1997) (limiting means-plus-function claim to non-smooth or conical passage structures where the specification "expressly distinguishes over prior art passages by stating that those passages are generally smooth-walled").

Although Kimberly-Clark seeks to draw support from a statement in each of the specifications that the "preferred material for the flaps . . . is a liquid pervious material," that statement does not justify the conclusion that the asserted claims must be read to cover both fluid pervious and fluid impervious flaps. That statement appears to be derived from a similar statement in Enloe's original parent application, which referred to the flap material as "preferably . . . fluid permeable," even though the claims of that application were not limited to fluid pervious flaps. The reference to the preferred material of the flaps being liquid pervious was carried over, perhaps by mistake, in the application that became Enloe I, even though the claims of that application were all expressly limited to fluid pervious flaps. Because that statement, when made in the Enloe I specification, plainly did not mean that the claims of that patent should be read to include fluid pervious flaps, it cannot reasonably be read to have assumed a different meaning when it was carried over into the specifications of Enloe II and Enloe III. *See Abtox, Inc. v. Exitron Corp.*, 131 F.3d 1009, 1010, 46 USPQ2d 1735, 1735-36 (Fed. Cir.), *modifying* 122 F.3d 1019, 43 USPQ2d 1545 (Fed. Cir. 1997) (improper to construe the same term in related patents differently); *Jonsson v. Stanley Works*, 903 F.2d 812, 818, 14 USPQ2d 1863, 1869 (Fed. Cir. 1990) (construction of the same term in related patent relevant to an understanding of that term in patent at issue). We therefore agree with the district court that the specifications of the three patents do not support Kimberly-Clark's assertion that Enloe's invention included diapers with fluid impervious as well as fluid pervious flaps.

The prosecution history is consistent with the claim construction adopted by the district court. After narrowing his claims in Enloe I to fluid pervious flaps and including the language distinguishing Beckestrom on that ground in his specification, Enloe retained the language distinguishing Beckestrom in the specifications of Enloe II and Enloe III and did not raise the "fluid pervious" issue again during the prosecution of any of the three patents. Although Enloe originally specified "fluid pervious" flaps in the application that became Enloe II, he deleted the reference in the claims to "fluid pervious" flaps at the time of the interference in order to copy the claims of the Lawson patent. There is no suggestion in the prosecution history that the deletion of that language had the effect of recapturing fluid impervious flaps. Indeed, the exclusion of Lawson's fluid impervious claims from the interference, and the denial of Enloe's motion seeking to add those claims, indicates that the examiner and the Board of Patent Appeals and Interferences understood that Enloe had disclaimed fluid impervious flaps notwithstanding the omission of the express references to fluid pervious flaps.

Finally, invoking the doctrine of claim differentiation, Kimberly-Clark argues that claim 1 of Enloe II should be read to include fluid impervious flaps because claim 26 of

Enloe II, unlike claim 1, is expressly limited to fluid pervious flaps. Claim 26 requires that the flaps, "when placed in contact with wet skin of a wearer, permit[] moisture to escape from the surface of the skin so contacted." While it is not clear that this limitation is equivalent to fluid perviousness, the doctrine of claim differentiation cannot in any event alter a definition that is otherwise clear from the claim language, the written description, and the prosecution history. *O.I. Corp.*, 115 F.3d at 1582, 42 USPQ2d at 1781; *see also Tandon Corp. v. U.S. Int'l Trade Comm'n*, 831 F.2d 1017, 1024, 4 USPQ2d 1283, 1288 (Fed. Cir. 1987) ("Whether or not claims differ from each other, one can not interpret a claim to be broader than what is contained in the specification and claims as filed.").

Enloe II and Enloe III cannot be correctly construed to cover what was expressly disclaimed. *See Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328, 1331, 56 USPQ2d 1208, 1210 (Fed. Cir. 2000). Therefore, the district court correctly limited all three patents to fluid pervious flaps.

B. The district court further construed "fluid pervious" to mean "pervious without pressure." While the term "pervious" is not defined in the specification, Enloe set out a meaning for that term during prosecution: "open to passage or entrance; permeable." Enloe further defined "impervious" to mean the opposite: "not open to passage or entrance, or impermeable." Such a general definition is not particularly helpful because any material, under sufficient pressure, will become pervious. The specification, however, provides that both the bodyside liner and the flaps are fluid pervious and that the flaps may be made from the same material as the bodyside liner or an alternative fluid pervious material. Enloe I, col. 4, ll. 55-60; Enloe II, col. 5, ll. 31-35; Enloe III, col. 5, *ll*. 19-23. Neither the specification nor the prosecution history draws any distinction between the way the term "pervious" is used in relation to the flaps and the way the same term is used in relation to the bodyside liner.

Although Kimberly-Clark admits that the bodyside liner must be pervious without pressure, it argues that the inner flaps may be regarded as pervious as long as they are pervious under pressures of up to six pounds per square inch. Because the inner flaps are allegedly subject to greater pressure than the bodyside liner during normal use, Kimberly-Clark argues that a lesser degree of perviousness is required to render them "fluid pervious" for purposes of the Enloe patents. In support of its theory, Kimberly-Clark offers a "normal use" pressure measurement test that is not disclosed in the specification or the prosecution history, is not used in the industry, and, according to the district court, was "concocted solely for purposes of this litigation."

If Enloe intended to define the term "fluid pervious" in the manner that Kimberly-Clark now asserts, he should have defined the term in that way in the patents. Instead, he offered a dictionary definition consistent with the way the evidence showed the term is used in the industry to refer to fluid pervious bodyside liners—pervious without pressure. Enloe did not give notice that "fluid pervious" may mean something entirely different when used in reference to the inner flaps, and he even suggested that the inner flaps can be made from exactly the same material as the fluid pervious bodyside liner, which strongly suggests that the term "fluid pervious" was being used in the same way for both structures.

The public notice function of patents is defeated if a patentee can subsequently and substantially alter the meaning of his claims by a post-hoc, litigation-driven "definition" unsupported by the specification. *See Bell & Howell Document Mgmt. Prods. Co. v. Altek Sys.*, 132 F.3d 701, 706, 45 USPQ2d 1033, 1038 (Fed. Cir. 1997) ("Once a dispute over claim construction arises, 'experts' should . . . not be heard to inject a new meaning into terms that is inconsistent with what the inventor set forth in his or her patent and communicated, first to the patent examiner and ultimately to the public."). Absent some indication to the contrary, the term fluid pervious should therefore be accorded a consistent meaning throughout the specification. *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1310, 51 USPQ2d 1161, 1169 (Fed. Cir. 1999) (holding that, as a general principle, the same word appearing in the same claim should be interpreted consistently absent a different definition). Because the Enloe patents do not distinguish between the bodyside liner and the flaps with respect to the feature of fluid perviousness, and because the bodyside liner is considered fluid pervious if it is fluid pervious without pressure, the inner flaps must be considered fluid pervious under the same conditions.

Kimberly-Clark has acknowledged that the accused diapers do not infringe if the fluid pervious limitation applies to the Enloe II and Enloe III patents and if fluid pervious means pervious without pressure. We therefore uphold the district court's judgment of non-infringement. In light of our ruling, it is unnecessary for us to reach the additional claim construction issue that the district court addressed and Kimberly-Clark challenged on appeal.

APPENDIX B

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

[Filed Nov. 3, 1999]

Civil Action No. 98C0756C
Case No. 98 C 0756 C

KIMBERLY-CLARK CORPORATION,
Plaintiff,
v.
TYCO INTERNATIONAL (US), INC.,
THE KENDALL COMPANY,
INBRAND CORPORATION, AND CONFAB, INC.
Defendants.

JUDGMENT IN A CIVIL CASE

WHEREAS, the Court has construed the claims of U.S. Patent 4,704,116, U.S. Patent 5,415,644, and U.S. Patent 5,559,338 in its Opinion and Order dated November 1, 1999; and

WHEREAS, the parties have advised the Court that, under the Court's claim construction, there is no disputed issue of material fact relating to infringement, and the defendants are not liable for infringement;

IT IS ORDERED AND ADJUDGED that judgment is entered in favor of defendants and against plaintiff, and this case is CLOSED.

/s/ Joseph W. Skupniewitz
JOSEPH W. SKUPNIEWITZ
Clerk of Court

Nov. 3, 1999
Date

APPENDIX C

IN THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF WISCONSIN

98-C-756-C

KIMBERLY-CLARK CORPORATION,
Plaintiff,

v.

TYCO INTERNATIONAL (US), INC.,
THE KENDALL COMPANY,
INBRAND CORPORATION, AND CONFAB, INC.,
Defendants.

OPINION AND ORDER

In this civil action for monetary and injunctive relief, plaintiff Kimberly-Clark Corporation contends that defendants Tyco International (US), Inc., The Kendall Company, Inbrand Corporation, and Confab, Inc., are infringing the claims of three patents plaintiff owns on the design of diapers: U.S. Patent No. 4,704,116 (Enloe I), U.S. Patent No. 5,415,644 (Enloe II), and U.S. Patent No. 5,599,338 (Enloe III). Jurisdiction is present. 28 U.S.C. § 1338(a). Previously I denied plaintiff's motion for summary judgment of infringement of the claims of the Enloe III patent and defendants' motion for summary judgment of non-infringement of the claims of Enloe I and Enloe II. Presently before the court are both parties' supplemental briefs addressing claim construction issues that were the subject of a September 15, 1999 *Markman* hearing.

In light of the *Markman* hearing and in reconsideration of my earlier ruling on summary judgment, I conclude that the specifications and prosecution histories of the Enloe II and III patents indicate that neither of those patents encompasses fluid impervious inner flaps. In addition, I reverse my earlier holding on summary judgment that the patents cover flaps pervious under pressures encountered during the normal use of a diaper and conclude that the flaps must be pervious to the same degree as the bodyside liner. Finally, with regard to the Enloe II and III patents, I reverse my earlier ruling on summary judgment and conclude that less than the whole distal edge of flaps must be spaced away from the bodyside liner and that the flaps must be attached to the liner at their ends.

The following undisputed facts are taken from facts proposed by the parties for purposes of their earlier motions for summary judgment. In addition, I understand both parties to invite the court to rely upon undisputed facts taken from affidavits attached to their supplemental *Markman* briefs.

FACTS

Plaintiff is a corporation organized under the laws of Delaware with its principal place of business in Irving, Texas. Defendant Tyco International (US), Inc., is a corporation organized under the laws of Massachusetts with its principal place of business in Exeter, New Hampshire. Defendant Kendall Company was a subsidiary of Tyco. Sometime before plaintiff filed its complaint, defendant Tyco acquired defendant Inbrand and merged it with defendant Kendall. Defendant Kendall has since been renamed the Tyco Healthcare Group LP. Defendant Confab was acquired by Confab Holding Co. and is now doing business as the Kendall-Confab Retail Group, Inc.

This case involves a design development in the diaper industry: the use of stand-up inner flaps. Inner flaps slow the movement of liquid waste along the surface of the diaper's liner, giving the diaper's absorbent core more time to absorb the liquid waste and reducing leakage at the elasticized leg openings. One of plaintiffs employees, Kenneth Enloe, is the named inventor on the three patents at issue in this case: U.S. Patent No. 4,704,116 (Enloe I), U.S. Patent No. 5,415,644 (Enloe II), and U.S. Patent No. 5,599,338 (Enloe III). Plaintiff has been using Enloe's inventions in its Huggies® brand diapers since 1989. The flaps are known by a variety of names, including "inner leg cuffs" and "barrier cuffs." The parties use "inner flaps" and "barrier cuffs" synonymously. The accused products are sold under a variety of names.

An inner flap has two long edges that run parallel to the longitudinal centerline of a diaper. The upper edge, away from the garment, is called the distal edge. The edge contacting the garment is called the proximal edge. Each barrier cuff also has two short ends. If the cuffs are attached to, rather than made from, the material of the bodyside liner, they may be made of a different material from the bodyside liner. Figure 2 from the Enloe III patent shows the frontal view of a cross-section of a diaper with barrier cuffs:

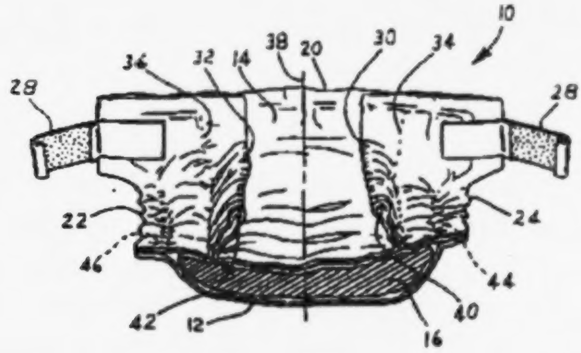

FIG. 2

The inner flaps or barrier cuffs are labeled 30 and 32 and are shaded. The bodyside liner or top surface is labeled 14. The longitudinal centerline is labeled 38. The absorbent core is labeled 16. The gasketing leg cuffs, which are different from the barrier cuffs, are labeled 22 and 24.

Enloe I

All of the asserted claims of the Enloe I patent require that the flaps be "fluid pervious" or "liquid pervious." The terms are synonymous. The parent application of Enloe I, filed in July 1984, recited "two flaps extending toward each end." The original application was rejected as unpatentable over prior art, specifically Beckestrom U.S. Patent No. 4,490,148, which discloses a diaper with fluid impervious flaps. Faced with that rejection, Enloe abandoned his original application and filed the continuation-in-part that eventually became Enloe I. In the continuation-in-part application, Enloe added three paragraphs to the specification intended to distinguish his invention from Beckestrom's. He describes Beckestrom's prior art as having "liquid-tight" side flaps. Enloe then explains that Beckestrom's design has "resulted in the emergence of other problems." For example, "the waterproof material of the flaps" can cause urine, moisture and liquid fecal material to become trapped against the skin and cause irritation. Enloe then explains how his invention improves upon Beckestrom's: "the present application teaches an improved disposable garment which provides fluid pervious flaps." He describes the flaps as "made up of water pervious materials." In allowing the claims, the examiner stated, "The claims as amended recite the necessity of a fluid permeable flap and elastic in the flap as well as at the leg openings. This combination overcomes prior art."

Independent claim 1 of the Enloe I patent includes the requirement for "fluid pervious" flaps and a "liquid pervious" bodyside liner. The claims encompass:

> An absorbent garment comprising:
>
> a back sheet;
>
> a liquid pervious bodyside liner, essentially coterminous with said back sheet, defining front and back waist sections and opposed first and second sides connecting said waist section(s), including a pair of leg sections

delimited along said sides, each of said leg sections having a tensioned elastic member disposed therealong, forming elasticized leg gathers;

an absorbent body disposed between said liner and back sheet; and

first and second elasticized fluid pervious flaps attached to or formed from said bodyside liner and spaced inwardly of said leg elastic members, respectively, defining a waste containment package.

In *Kimberly-Clark Corp. v. Procter & Gamble Distributing Co.*, No. C89-502WD, 1191 U.S. Dist. LEXIS 19389 (W.D. Wash. 1991), *aff'd in part and vacated in part, Kimberly-Clark Corp. v. Procter & Gamble Co.*, 973 F.2d 911 (Fed. Cir. 1992), plaintiff sued Procter & Gamble for infringement of the Enloe I patent. The parties agree that Judge Dwyer's construction of the Enloe I claim term, "fluid pervious," in that case should be utilized in this case. Judge Dwyer construed the term "fluid" to mean "urine and liquified or runny BM, the body exudates which diapers are intended to contain." *Id.* at *11. He construed "pervious" to mean "that the diaper material would allow a body exudate to pass or transfer through" during the diaper's "normal use." *Id.*

One possible test of perviousness is the "hydrostatic head" test. In this test, the diaper material is attached to the bottom of a hollow glass tube. Liquid is then added slowly to the tube. The test is stopped when liquid penetrates the diaper material. The pressure required for liquid to pass through the material is determined by calculating the weight of the liquid above the test material at the point of penetration. One of defendants' diaper scientists may have employed the hydrostatic head test while developing the flaps in controversy and determined an approximate dividing line between perviousness and imperviousness, although his work was not relied upon in developing the allegedly infringing products.

The hydrostatic head test is not specified in the Enloe I patent. In fact, nowhere in the patent is any test described to define pervious. Judge Dwyer did not use this test to determine whether Procter & Gamble's inner flaps were fluid pervious. Instead, he relied on the "runoff" test, in which flap material with absorbent material beneath was attached to a solid surface inclined at 10 degrees. Approximately 25 milliliters of synthetic liquid urine were then allowed to run down the inclined flap material. The absorbent material beneath the flap was weighed before and after the test to determine whether any liquid had penetrated the flap material. Finding that little if any liquid had reached the absorbent material, Judge Dwyer held that Procter & Gamble's flaps were impervious to fluid and thus did not infringe the Enloe I patent. That judgment on infringement was later vacated after the parties settled the issue privately.

As part of the litigation before Judge Dwyer, plaintiff sought to have declared invalid claims of a patent owned by Procter & Gamble issued to inventor Michael Lawson, U.S. Patent No. 4,695,278. Judge Dwyer found that the Lawson and Enloe patents covered "substantially identical subject matter." *Kimberly-Clark Corp.*, No. C89-502WD, 1191 U.S. Dist. LEXIS 19389 at *5. Because Judge Dwyer found that Enloe had anticipated the Lawson claims related fluid pervious flaps (claims 1, 2, 4, 5, 6, 7, 10, 11, 12, 14, 16, 19, 20, 23, 24 and 26), he invalidated those Lawson claims. *See id.* at *25. However, because Judge Dwyer also found that Enloe had given up his claims to fluid impervious flaps during the prosecution of Enloe I, he did not invalidate the claims of the Lawson patent related to impervious flaps (claims 13, 17, 21, 25, 27 and 28) in light of Enloe I. *See id.* Upon appeal, Judge Dwyer's determination of the invalidity of certain claims of the Lawson patent was left undisturbed by the Federal Circuit. *See Kimberly-Clerk Corp.*, 973 F.2d at 914.

Defendants' expert applied the runoff test to all of the accused products in this case and found that they were even less pervious than the Procter & Gamble flaps that Judge Dwyer had decided did not infringe the Enloe I patent. In addition, defendants' expert examined both the non-infringing Procter & Gamble flaps and defendants' flaps under a microscope. He was able to detect small pores in the Procter & Gamble flaps but not in defendants' flaps.

When fluid is pressured into the flap material rather than allowed to run off without pressure, the fluid is more likely to penetrate the material. Plaintiff alleges that it has performed tests that indicate that defendants' inner flaps are pervious under pressure.

Enloe II

As part of the prosecution of the Enloe II patent, plaintiff provoked an interference with the Lawson Patent No. 4,695,278. When the patent office declared the interference, it omitted all the Lawson dependent claims (13, 17, 21, 25 and 27) directed to "liquid impervious" flaps. As a result of the declaration of the interference, Enloe included the Lawson claims in his Enloe II application, but omitted all the claims relating to liquid impervious flaps (13, 17, 21, 25, and 27) because they were not part of the interference that had been declared. Enloe then filed a motion in the interference to add the claims relating to the liquid impervious flaps to the count of the interference. The patent office rejected this motion, stating that the Lawson claims relating to liquid impervious flaps were "not anticipated" by the broader claims in "the count" that referred to flaps without specifying their perviousness.

The specification of the Enloe II patent contains the same language that appeared in the specification of Enloe I distinguishing Enloe's invention from Beckestrom's and describing his improvement through the use of fluid pervious flaps. In an amendment filed on September 17, 1993, Enloe offered the following definition of "pervious" for purposes of the prosecution of Enloe II:

> In the above claims (and elsewhere in Applicant's specification and claims), the term "*pervious*" is used in the ordinary sense as defined in *The American Heritage Dictionary* (Second College Edition, 1982), at page 927, a copy of which is attached, namely "Open to passage or entrance; permeable"; and the term "*impervious*" is used in the opposite sense, i.e., not open to passage or entrance, or impermeable.

In the same amendment, Enloe noted that the examiner had stated "that claims containing a recitation that the 'flaps' (barrier cuffs) were permeable may be patentable . . . . The above claims are accordingly presented for the Examiner's consideration."

The Enloe II patent requires the presence of inner flaps that have a central portion of the distal edge (the edge furthest from the bodyside liner) directed toward the longitudinal centerline of the garment by virtue of the way in which the inner flaps are attached to the bodyside liner of the diaper. Claim 1 is illustrative of this requirement:

> An integral disposable absorbent article comprising:
>
> a liquid pervious topsheet having a top surface;
>
> * * * * *
>
> a pair of barrier cuffs,
>
> (a) each barrier cuff having a proximal edge and a distal edge;
>
> (b) each barrier cuff being disposed inboard of one of the gasketing cuffs,
>
> (c) at least a portion of each barrier cuff being attached to the top surface, and

(d) a central portion of the distal edge of each barrier cuff being directed, by means of said portions being attached to the top surface, toward the longitudinal centerline of the integral disposable article, between the gasketing cuffs of the integral disposable absorbent article; and

means for tensioning the barrier cuffs, to space a portion of the distal edge of each barrier cuff away from the top surface of the topsheet, whereby a channel is formed by the two barrier cuffs and a portion of the topsheet between the barrier cuffs.

Proposed claim 89 of the Enloe II patent was rejected by the examiner as unpatentable over Tetsujiro (Japanese Utility Model 41-18359) in view of Karami (U.S. Patent No. 4,527,989) and as being unpatentable over Karami (U.S. Patent No. 4,527,989) in view of Tetsujiro (Japanese Utility Model 41-18359). Eventually, the examiner allowed claim 89 as claim 1 of Enloe II after plaintiff added the language from (c) and (d) above, specifying that at least a portion of the barrier cuffs would be attached to the bodyside liner and that by means of that attachment a central portion of the distal edge of the cuffs would be directed inward:

(c) at least a portion of each barrier cuff being attached to the top surface, and

(d) a central portion of the distal edge of each barrier cuff being directed, by means of said portions being attached to the top surface, toward the longitudinal centerline of the integral disposable absorbent article, between the gasketing cuffs of the integral disposable absorbent article.

Claim 1 is a modified version of rejected claim 89, which was substantively identical to claim 1 except that it did not include the limitations of (c) and (d).

Claim 12 of the Enloe II patent requires the presence of "adhesive means disposed adjacent each of the ends of the barrier cuffs for securing a portion of each barrier cuff." Claim 12 is dependent upon claim 6, an independent claim with language similar to that quoted above from claim 1.

Figure 7 of the patent shows "alternative embodiments of the garment" where the flaps are "curvilinear." Describing the alternative embodiment displayed in FIG. 7, the inventor states that "as before flaps 30, 32 may be folded and bonded to inner liner 14 at the respective ends of each flap. The flaps are folded or bonded whereby edges 54, 56 are directed toward centerline 38."

The examiner allowed the Enloe II patent to issue because it specified barrier cuffs directed inward by means of their attachment to the topsheet of the diaper. As the examiner stated in his reasons for allowance:

> Applicant distinguishes over the best prior art of record with an integral disposable absorbent article having barrier cuffs inboard of the leg gasketing cuffs that are directed inwardly towards the longitudinal center of the article by means of their attachment to the top surface of the article [and] that are elasticized which is not shown nor fairly suggested by the best prior art of record.

At least some of defendants' products do not achieve inward directionality by attaching the *ends* of the inner flaps to the bodyside liner. These products have barrier cuffs made from a separate piece of material in the shape of a rectangle that is glued to the bodyside liner by securing only the proximal edge to the bodyside liner. These products do not have the ends of the inner flaps attached to the bodyside liner to direct the central portion of their distal edge toward the longitudinal centerline.

Enloe III

The specification of the Enloe III patent contains the same language that appeared in the specifications of Enloe I and II distinguishing Enloe's invention from Beckestrom's and describing Enloe's improvement through the use of fluid pervious flaps. Claim 1 of the Enloe III patent is substantively identical to rejected claim 89 from the Enloe II patent. That is, claim 1 of the Enloe III patent is the same as claim 1 of Enloe II except for limitations (c) and (d) of Enloe II. The same examiner examined the applications for Enloe II and Enloe III. Before accepting claim 1 of Enloe III, he rejected it for double patenting over claim 1 of Enloe II. However, plaintiff issued a terminal disclaimer to overcome the double patent rejection, disclaiming rights to extend the life of claim 1 of Enloe II through the issuance of claim 1 of Enloe III. The patent then issued. Claim 1 of the Enloe III patent encompasses:

> 1. An integral disposable absorbent article comprising:
>
> a liquid pervious topsheet having a top surface;
>
> a backsheet connected to the topsheet;
>
> an absorbent core disposed between the topsheet and the backsheet;
>
> a pair of elastically contractible gasketing cuffs, each disposed adjacent to a longitudinal edge of the absorbent article;
>
> a pair of barrier cuffs,
>
> > (a) each barrier cuff having a proximal edge and a distal edge, and
> >
> > (b) each barrier cuff being disposed inboard of one of the gasketing cuffs; and
>
> means for tensioning the barrier cuffs, to space a portion of the distal edge of each barrier cuff away from the top surface of the topsheet, whereby a channel is formed by

> the two barrier cuffs and a portion of the topsheet between the barrier cuffs.

When the ends of the inner cuffs are attached to the bodyside liner, the ends of the distal edges of those cuffs are necessarily in contact with the bodyside liner. However, a central portion of the distal edge of the cuffs is spaced away from the liner by means of an elastic that tensions the cuff when the diaper is in use. However, if the cuffs are *not* attached at the ends to the bodyside liner, then the *entire* distal edge of the cuffs is spaced away from the bodyside liner when the diaper is in use. Defendants' inner cuffs are not attached at the ends to the bodyside liner. Thus, the entire distal edge is spaced away from the bodyside liner when the diaper is in use.

OPINION

Determination of patent infringement is a two-step process. *See Desper Products, Inc. v. QSounds Labs, Inc.*, 157 F.3d 1325, 1332 (Fed. Cir. 1998). First, the court must construe the claim as a matter of law to determine its proper scope and meaning. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed Cir. 1995), *aff'd*, 517 U.S. 370 (1996). In doing so, the court must consider the claim language, patent specification and prosecution history. *See id.* The court should consider extrinsic evidence only if necessary. *See id.* Second, the trier of fact compares the properly construed claim to the allegedly infringing product. *See Desper Products*, 157 F.3d at 1332. Summary judgment is appropriate only if the composition of the allegedly infringing product is undisputed so that there is no genuine dispute of material fact. *See id.*

A. *Do Enloe II and III Encompass Fluid Impervious Flaps?*

In the earlier ruling on summary judgment, I correctly understood plaintiff to concede that Enloe I was limited to fluid pervious flaps but misunderstood plaintiff to concede that Enloe II was similarly limited. I also held that the prosecution history of the Enloe III patent showed that it was limited to fluid pervious flaps. Plaintiff argues that Enloe II is not limited to fluid pervious flaps and urges reconsideration of the decision that the Enloe III patent is so limited. Having considered whether the Enloe II patent is so limited and having reconsidered whether the Enloe III patent is so limited, I hold that both patents are limited to fluid pervious flaps.

Both parties agree that Enloe I does not encompass fluid impervious flaps. The prosecution history of Enloe I demonstrates that the original application was rejected by the patent examiner, at least in part, because prior art from Beckestrom U.S. Patent No. 4,490,148 discloses a diaper with fluid impervious flaps. Faced with that rejection, Enloe abandoned his original application and filed the continuation-in-part that eventually became Enloe I. In the continuation-in-part application, Enloe added three paragraphs to the specification intended to distinguish his invention from Beckestrom's. He describes Beckestrom's prior art as having "liquid-tight" side flaps and explains that Beckestrom's design has "resulted in the emergence of other problems": "the waterproof material of the flaps" causes urine, moisture and liquid fecal material to become trapped against the skin and cause irritation. He explains that his invention improves upon Beckestrom's: "the present application teaches an improved disposable garment which provides fluid pervious flaps" composed "of water pervious materials." Apparently recognizing that Enloe had abandoned his claim to fluid impervious flaps, the examiner allowed the claims: "The claims as amended recite the necessity of a fluid impermeable flap and elastic in the flap as well as at the leg openings. This combination overcomes prior art."

Although plaintiff concedes that this language and the prosecution history of Enloe I limit its scope to fluid pervious flaps, plaintiff insists that Enloe II and III are not so limited and, in fact, were prosecuted in part to recapture the claim to fluid impervious flaps that was abandoned in the prosecution of Enloe I. In support of its position, plaintiff advances three arguments. First, it points out that in the claims of Enloe I the flaps are described as "fluid pervious," but in the claims of Enloe II and III the flaps are not described as fluid pervious; that are simply called flaps or "cuffs." Second, the specification of all three patents states that "liquid pervious material is preferred," implying that liquid impervious materials were the non-preferred embodiment contemplated by Enloe. Third, claim 26 of Enloe II describes the flaps as "when placed in contact with wet skin of a wearer, permitting moisture to escape from the surface of the skin so contacted." Plaintiff argues that if the claims of Enloe II encompass only fluid pervious flaps, the language from claim 26 would be unnecessary. Therefore, the doctrine of claim differentiation compels the conclusion that the other claims encompass fluid impervious flaps.

If only it were that simple. Like its flaps, plaintiffs argument is full of holes. First, Enloe included exactly the same three paragraphs from the specification of Enloe I distinguishing his invention from Beckestrom's in the specification of both Enloe II and Enloe III. From the fact that the specifications of both Enloe II and III describe prior art as encompassing fluid impervious flaps and teach how the Enloe patents improve upon prior art by the use of fluid pervious flaps, I draw the inference that neither Enloe II nor III encompasses fluid impervious flaps. Plaintiff argues that what distinguishes Enloe's invention from Beckestrom's is not the perviousness of his flaps but the combination of inner flaps (whether pervious or impervious) and leg cuffs in the same diaper. If this is so, it does not explain why Enloe took such care to describe Beckestrom's prior art as fluid impervious and to explain why pervious flaps were an improvement.

Moreover, as late as 1993, during the prosecution of the Enloe II patent, Enloe's attorneys acknowledged in an amendment filed on September 17, 1993, that the examiner had stated "that claims containing a recitation that the 'flaps' (barrier cuffs) were permeable may be patentable . . . . The above claims are accordingly presented for the Examiner's consideration." Thus, available evidence from the Enloe II and III specifications and the patents' prosecution histories suggest strongly that, like the flaps described in Enloe I, the flaps contemplated by Enloe II and III are pervious. "The best source for understanding a technical term is the specification from which it arose, informed, as needed, by the prosecution history . . . . [T]he evolution of restrictions in the claims . . . reveals how those closest to the patenting process—the inventor and the patent examiner—saw the subject matter." *Multiform Dessicants v. [sic] Inc., v. Medzam, Ltd.*, 133 F.3d 1473, 1478 (Fed. Cir. 1998). Here the specifications and prosecution histories clearly indicate that the inventor and patent examiner understood the flaps to be pervious and that the perviousness was a patentable improvement over impervious flaps.

In addition, the interference between the Enloe II application and Procter & Gamble's Lawson Patent No. 4,695,278 indicates that Enloe II is limited to fluid pervious flaps. When the patent office declared the interference, it omitted all the Lawson dependent claims (13, 17, 21, 25 and 27) directed to "liquid impervious" flaps. As a result of the declaration of the interference, Enloe moved the Lawson claims to the Enloe II application, but omitted all the claims relating to liquid impervious flaps (13, 17, 21, 25, and 27) because they were not part of the interference that had been declared. Enloe then filed a motion in the interference to add the claims relating to the liquid impervious flaps to the count of the interference. The patent office rejected this motion, stating that the Lawson claims relating to liquid impervious flaps were not covered by the broader claims in the interference that referred to flaps without specifying their perviousness. Thus, although Enloe won the interference regarding claims related to liquid pervious flaps, liquid impervious flaps were not included in that victory despite the broad claim Enloe made to flaps regardless of their perviousness. The conclusion to be drawn from the patent office's refusal to include the Lawson claims relating to the liquid impervious flaps in the interference is that such flaps were not invented by Enloe and not patentable by him.

This is the same conclusion that was drawn by Judge Dwyer in the 1991 lawsuit between plaintiff and Procter & Gamble. Although Judge Dwyer found that Enloe had priority of invention over certain claims in the Lawson patent, he did not find that Enloe had priority with regard to the claims relating to impervious flaps (dependent claims 13, 17, 21, 25 and 27). The Federal Circuit affirmed Judge Dwyer's ruling with regard to Enloe's priority over Lawson with regard to certain claims and left undisturbed his ruling that Enloe was not entitled to the claims relating to impervious flaps. In addition, in the district court of Delaware, Procter & Gamble successfully sued Paragon Trade Brands for infringement of dependent claim 17 of the Lawson patent because Paragon's flaps were fluid impervious. *See Procter & Gamble v. Paragon Trade Brands*, 989 F. Supp. 547, 575-76 (D. Del. 1997). Both of these cases indicate that fluid impervious flaps are not encompassed by Enloe's patents.

That each of the Enloe patents describes liquid pervious material as "preferred" does not necessarily mean that the patent encompasses liquid impervious material as well. As explained in the earlier order on summary judgment, a general claim limitation may be restricted to a specific embodiment if the inventor commits himself to that embodiment through the prosecution history and by using that embodiment to distinguish the invention over prior art. *See I.O. Corp. v. Tekmar Co. Inc.*, 115 F.3d 1576, 1581 (1997). In *Tekmar*, the Federal Circuit held that the term "passage" did not encompass smooth-walled structures because the structures contemplated by the written description in the patent were nonsmooth and the description distinguished prior art by stating that the older passages were generally smooth-walled. Similarly, in this case, the prosecution history and the description of prior art in each of the patents indicate clearly that Enloe used a fluid pervious embodiment of the flaps to distinguish his invention over prior art. In doing so, he committed himself to a fluid pervious embodiment of the flaps. Therefore, despite the fact that each of the patents states that liquid pervious material is merely preferred, each is limited to fluid pervious flaps.

Claim 26 of Enloe II specifies that the flaps permit "moisture to escape from the surface of the skin," in other words, that the flaps are fluid pervious. Plaintiff contends that because claim 26 specifies that the flaps are fluid pervious, other broader references to flaps must encompass flaps that are pervious and impervious; if all the flaps were fluid pervious, there would be no need to specify that the flaps in claim 26 are fluid pervious. As plaintiff points out, the doctrine of claim differentiation supports its construction. *See Tandon Corporation v. U.S. International Trade Commission*, 831 F.2d 1017, 1023 (Fed. Cir. 1987) ("There is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims. To the extent that the absence of such difference in meaning and scope would make a claim superfluous, the doctrine of claim differentiation states the presumption that the difference between claims is significant."). Although there is logic to plaintiffs argument, it is impossible to reconcile it with either the prosecution of the patent or its own specification, which as noted before, distinguishes prior art on the basis of perviousness.

The Federal Circuit addressed an analogous dilemma in *Tandon*, 831 F.2d 1017. There, an independent claim in the patent at issue required a transducer (a magnetic head that receives and transfers information from and to both sides of a floppy disk) to be "non-gimballed" (in the disk drive industry, the term "gimballed" refers to a suspension system that allows the magnetic head to pitch and roll). *See id.* at 1020 and n.2. The patent holder argued that because one claim specified that the transducer be non-gimballed, the doctrine of claim differentiation compelled the conclusion that other claims encompassed transducers that were gimballed. The Federal Circuit disagreed, holding that "the specification and prosecution history require that the claims be limited to a non-gimballed, fixed, lower transducer." *Id.* As the Federal Circuit explained, "claims may not be construed one way in order to obtain their allowance and in a contrary way against infringers." *Id.* at 1021. Even though only one claim specified that the transducer be non-gimballed, the Federal Circuit held that the specification and prosecution history compelled the conclusion that all of the claims were limited to non-gimballed transducers. Similarly, in this case, even though claim 26 specifies that the flaps be fluid pervious, the specification and prosecution history compel the conclusion that all of the claims are limited to fluid pervious flaps. In short, the specifications and prosecution histories of Enloe II and III compel the conclusion that, like Enloe I, those patents encompass only fluid pervious flaps and do not encompass fluid impervious flaps.

B. *Must The Flaps Be As Pervious As The Bodyside Liner?*

There is no dispute between the parties about what fluid perviousness must mean in regard to the bodyside liner. The bodyside liner must be pervious with or without pressure placed upon it in order to work properly. Like the bodyside liner, the inner flaps are also described by Enloe I as "fluid pervious," and as explained above, the same limitation applies to the flaps described in Enloe II and III. The parties dispute whether the inner flaps must also be pervious with or without pressure. In the order on summary judgment I agreed with plaintiffs contention that even if defendants' flaps are pervious only under pressure, they still infringe Enloe's patents if they are pervious during the normal use of a diaper. I held that the *Markman* hearing would be used to determine what range of pressures flaps encounter in normal use and that the trier of fact could then determine whether defendants' flaps were pervious under those conditions.

Upon reflection and with the benefit of the *Markman* hearing, I am persuaded that this ruling was an error. What became evident during the *Markman* hearing was that plaintiff had absolutely no measurement of pressure in mind during the prosecution of any of its patents. The test plaintiff presented as the appropriate test for pressure during the normal use of a diaper was concocted solely for purposes of this litigation and employed instruments apparently unavailable at the time Enloe prosecuted his patent. At this time, this test cannot provide the appropriate definition of pervious as it pertains to the flaps. Because the *Markman* hearing made clear that Enloe relied on no industry standard test for a definition of perviousness that would have given his competitors notice of the meaning of the term at the time he prosecuted his patents, the only appropriate definition (if there is one) must be found in the patent itself.

The patent refers to two objects as liquid or fluid pervious: the bodyside liner and the flaps. The patent states that the flaps "may" be made from the bodyside liner, but does not suggest other materials from which they may be made. Instead, the only notice the patent provides regarding degrees of perviousness is that at least the bodyside liner must be instantly pervious without pressure; otherwise the diaper would not work. Like the liner, the flaps are described simply as "pervious." Because the same words are to be given the same meaning, the inevitable conclusion is that both the "pervious" flaps and the "pervious" bodyside liner must be pervious without regard to pressure.

This true [sic] despite the fact that claim 1 contemplates that the flaps may be formed from "or attached to" the bodyside liner. As explained in the order on summary judgment, logic dictates that flaps *made from* the bodyside liner must be pervious even without pressure. However, logic does not compel a similar conclusion for flaps that are *attached to* the bodyside liner. Such flaps could be made from a different material that is pervious only under some amount of pressure. But the onus was on Enloe at the time he prosecuted his patents to provide other inventors with some notice differentiating the perviousness of the bodyside liner from the perviousness of the flaps. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). An inventor is entitled to be his own lexicographer, but if he intends a special definition of a term he must state it clearly in the specification or file history. *See id.* Enloe did not provide a special definition at the time of the patent prosecution and plaintiff cannot do so now. Indeed, the only definition of "pervious" Enloe provided during the prosecution of Enloe II explicitly failed to adopt any specific meaning for the term relative to the flaps:

> In the above claims (and elsewhere in Applicant's specification and claims), the term "*pervious*" is used in the ordinary sense as defined in *The American Heritage Dictionary* (Second College Edition, 1982), at page 927, a copy of which is attached, namely "Open to passage or entrance; permeable"; and the term "*impervious*" is used in the opposite sense, i.e., not open to passage or entrance, or impermeable.

Just as the court is left without notice of what different degree of perviousness the flaps may possess compared to the bodyside liner, a competing inventor would have no fair warning of what she must avoid. Despite the common sense appeal of the idea that flaps encounter pressure during normal use, it is unfair to hold that the flaps are "pervious" within the meaning of the patent at some amount of pressure measured and designated by plaintiff many years after the patent issued. It is also outside the canon of claim construction that requires courts to construe claim language according to the standards of what those words would have meant to persons of ordinary skill in the art at the time of the application. *See W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556 (Fed. Cir. 1983). In *J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563 (Fed. Cir. 1997), the Federal Circuit explained that the inventor, who had literally built a better mouse trap, could not concoct a scientific test to define a term in a patent after the patent had issued:

> While Zeliger's test may have some common sense appeal, it provides no certainty to Eaton's competitors, who are entitled to know the point in time at which their products will infringe claim 1. Nor does Zeliger's test give any measure of certainty to Eaton, which is also entitled to know in advance how to test competing product for infringement of claim 1.

Similarly, in *Schering Corp. v. Amgen, Inc.*, 25 F. Supp. 2d 293 (D. Del. 1998), an inventor "urge[d] that it be allowed to use post-filing definitions to define disputed claim terms that a person of ordinary skill in the art of reading the patent could not have understood since the classification was not adopted or published until after the filing date." Because the plaintiffs purported definition in *Schering* was based on a classification not adopted at the time of the patent application, it was not adopted by the court. In this case, because plaintiffs definition of perviousness is based on tests not conducted or even conceived at the time of the patent application, it cannot be adopted. As the Federal Circuit explained in *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1345 (Fed. Cir. 1998):

> because a patent applicant has the burden to 'particularly point out [ ]and distinctly claim [ ] the subject matter

> which the applicant regards as his invention,' 35 U.S.C. § 112, ¶ 2, if the claim is susceptible to a broader and narrower meaning, and the narrow one is clearly supported by the intrinsic evidence while the broader one raises questions of enablement under § 112, ¶ 1, [a court should] adopt the narrower of the two.

In this case, the claim language is susceptible to both a broad and narrow reading of the term pervious as it relates to the flaps: it may mean as pervious as the bodyside liner or it could mean some other degree of pervious, depending on the material used to construct the flaps and the range of pressure they encounter. Because the broader construction raises questions of enablement under § 112, ¶ 1 (that is, raises questions whether others skilled in the art would be enabled to reproduce the invention and understand the scope of the patent), this court should adopt the narrower construction under the applicable claim construction principles. *See id.*

Because the Enloe patents use the same word "pervious" with regard to the bodyside liner and flaps, a person of ordinary skill in the art reading the patent would assume that "pervious" has the same meaning in reference to both parts of the diaper. Because pervious with regard to the bodyside liner must mean pervious without pressure, one of ordinary skill in the art reading the patent would be put on notice only that the flaps are also pervious without pressure. Any other interpretation would leave competitors in the dark regarding the scope of the patent. Therefore, I conclude that the Enloe patents encompass flaps that, like the bodyside liner, are pervious without pressure. Although common sense suggests that both the flaps and the bodyside liner will often be under some amount of pressure during normal use, this understanding cannot substitute for the simple fact that Enloe could have defined a standard or a test for perviousness as part of his three patent prosecutions, but chose not to.

As explained at the *Markman* hearing, there are several appropriate tests to measure whether flaps are pervious without pressure, including the run-off test employed by Judge Dwyer in the 1991 litigation and the side-seal test employed by Judge Longobardi during the 1997 litigation. If defendants' flaps are pervious under such conditions, they infringe on the claims of the Enloe patents relating to the perviousness of the flaps; if they are not, they do not.

C. *Flap Attachment and The Meaning Of "To Space A Portion" Away*

Defendants urge reconsideration of that part of the decision on summary judgment related to how the inner flaps are attached to the bodyside liner and interpreting the requirement that "a portion" of the distal edge be spaced away from the bodyside liner. In particular, defendants argue that the flaps must be attached at their ends and that only a portion of the distal edge of the flaps can be spaced away from the liner (at least some of defendants' flaps are attached only along their proximal edges; thus, they are not attached at the ends and the entire distal edge is spaced away from the liner). I am now persuaded that defendants' construction is the more reasonable.

The patent calls for "means for tensioning the barrier cuffs, to space *a portion* of the distal edge of each barrier cuff away from the surface of the topsheet." In the ruling on summary judgment, I held that, although it was a tortured construction, "a portion" could include the whole distal edge. Upon reconsideration, I am persuaded that "to space *a portion*" away can and should be given its ordinary meaning: that is, *less than the whole* distal edge is spaced away. As explained above with reference to the interpretation of the term "pervious," an inventor is entitled to be his own lexicographer, *see Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996), but words in a claim are to be given their ordinary and accustomed meaning unless it clearly appears the inventor used them differently. *See Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 758 (Fed. Cir. 1984). The onus was on Enloe to give the term "portion" a special definition if he intended it to have something other than its ordinary and accustomed meaning. He did not provide a special definition. The ordinary and accustomed meaning of "portion" is some part less that the whole. *See Webster's New International Dictionary*, 2d ed. (1957) (defining "portion" as "a part of a whole . . . . a part abstracted from a whole; a limited amount of quantity"). Because Enloe failed to provide any other definition, I must conclude that less than the whole distal edge is spaced away from the bodyside liner. If less than the whole distal edge is spaced away from the bodyside liner, however, there remains the need to determine which portion of the distal edge must be attached to the bodyside liner.

Defendants argue that it must be the ends of the distal edge that are attached. In the ruling on summary judgment, I disagreed with defendants' interpretation. I held that because dependent claim 12 of Enloe II required attachment at the ends but the same limitation could not be found in the independent claim from which it depended (claim 6), the narrow limitation of the dependent claim should not be read into the broader independent claim. *See Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 770 (Fed. Cir. 1983). Therefore, I concluded that the patent broadly covered any flap directed inward by means of its attachment to the bodyside liner, regardless whether that attachment occurred at the ends of the flaps.

Although it is a difficult and close question, I am now persuaded that this conclusion was in error for two reasons. First, I have concluded that because a portion (that is, less than the whole) of the distal edge is spaced away from the liner, a portion must also be attached to the liner. It seems the only portion of the distal edge that could be attached within the intended use of the diapers is the ends: if the distal edge of flaps were attached in the middle, they would be unlikely to contain the liquid exudates effectively. Secondly, as defendants argue, although dependent claim 12 refers specifically to attachment at the ends, the *only* teaching in the patents shows the flaps attached at their ends. Each drawing of the patented item shows attachment at the ends. Although plaintiff argues that figure 7 of Enloe II achieves inward directionality by attaching the inner flap to the bodyside liner along a curved line rather than by attachment at the ends, that interpretation of the figure is never made explicit in the patent. Instead, the description of figure 7 states that the flaps are attached at the ends and attributes the inward directionality of the flaps to folding and bonding: "As before flaps 30, 32 may be folded and bonded to inner liner 14 *at the respective ends of each flap*. The flaps are *folded or bonded whereby edges 54, 56 are directed toward centerline 38*." Thus, even figure 7 contemplates flaps attached at their ends. This would not place competitors on notice that some means other than attachment at the ends had been used in that one figure in contrast to all of the others. I conclude that the combination of the requirement that some portion of the distal edge be attached to the bodyside liner and the fact that the patent teaches only attachment at the ends of the flaps means that the most logical interpretation of the Enloe II and III patents is that the flaps must be attached at their ends.

This conclusion is supported by my new understanding of claim 1 of Enloe III. The decision on summary judgment interpreting claim 1 of Enloe III so that the entire distal edge of the flaps could be spaced away from the bodyside liner was supported by my erroneous understanding that claim 1 of Enloe III did not contain limitations (c) and (d) of claim 1 of Enloe II. Limitations (c) and (d) of claim 1 of Enloe II describe the flaps with:

> (c) at least a portion of each barrier cuff being attached to the top surface, and

> (d) a central portion of the distal edge of each barrier cuff being directed, by means of said portions being attached to the top surface, toward the longitudinal centerline of the integral disposable absorbent article, between the gasketing cuffs of the integral disposable absorbent article.

Limitation (c) indicates that at least a portion of the flap must be attached to the bodyside liner. Defendants argued that despite that fact that limitations (c) and (d) do not appear in claim 1 of Enloe III, they should be read into that claim because the same examiner required those limitations before allowing Enloe II to issue and thus must have also read them into Enloe III before allowing it to issue. I rejected that argument, reasoning that if the examiner had read limitations (c) and (d) into claim 1 of Enloe III, claims 1 of Enloe II and III would have been substantively identical and thus claim 1 of Enloe III would have been rejected for double patenting. Further, I reasoned that to read those limitations into claim 1 of Enloe III would place in doubt the claim's validity as a result of double patenting, contravening the doctrine of claim construction that patents should be presumed valid. *See* 35 U.S.C. § 282. Therefore, I held that there was no indication that claim 1 of Enloe III required any portion of the distal edge of the flap to be attached to the bodyside liner.

In so ruling, I was unaware that in fact claim 1 of Enloe III *was* rejected for double patenting over claim 1 of Enloe II and that consequently plaintiff had issued a terminal disclaimer in the prosecution of Enloe III to avoid rejection for double patenting over Enloe II. That disclaimer allows the court to read into claim 1 of Enloe III limitations (c) and (d) of claim 1 of Enloe II. When claim 1 of Enloe III is understood to require that "at least a portion" of the flap be attached to the bodyside liner, some light is shed on the requirement that "a portion of the distal edge" also be spaced away from the liner. One reading of limitations (c) and (d) of Enloe II is that some portion of the distal edges of the flaps must be attached to the bodyside liner. Although I need not decide the issue for purposes of this ruling, defendants offer somewhat persuasive evidence that the requirement of limitation (c) that "at least a portion" of the flap be attached to the top surface can mean only that at least a portion of the distal edge be attached to the top surface, because prior art from Tetsujiro already encompasses flaps attached by their proximal edges. If defendants' position is correct, it would lend even more support to my conclusion that some part of the distal edges of the flaps must be attached to the top surface and that this attachment must occur at the ends of the flaps.

CONCLUSION

In light of the *Markman* hearing and upon reconsideration, I conclude that none of the Enloe patents encompasses fluid impervious flaps. In addition, I conclude that the flaps must be pervious to the same degree as the bodyside liner, that is, pervious with or without pressure. Finally, I conclude that less than the whole distal edge of the flaps must be spaced away from the bodyside liner and that the ends of the flaps must be attached to the liner.

Having adopted these claim constructions, it remains to be decided whether any the accused products infringe upon the claims of the Enloe patents. *See Desper Products, Inc. v. QSounds Labs, Inc.*, 157 F.3d 1325, 1332 (Fed. Cir. 1998) (first step in determining patent infringement is claim construction; second is comparing accused products to claims as construed). Therefore, I will not grant either party's motions for summary judgement at this time. Instead, I will require the parties to advise the court whether they believe any issues remain for the trier of fact in light of the claim constructions adopted in this ruling.

ORDER

The parties are to advise the court by 1:00 p.m. central time, Thursday, November 4, 1999, whether issues remain for the trier of fact in the trial scheduled to begin November 8, 1999.

Entered this 1st day of November, 1999.

BY THE COURT:

/s/ Barbara B. Crabb
BARBARA B. CRABB
District Judge

APPENDIX D

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

98-C-756-C

KIMBERLY-CLARK CORPORATION,
Plaintiff,

v.

TYCO INTERNATIONAL (US), INC.,
THE KENDALL COMPANY,
INBRAND CORPORATION, AND CONFAB, INC.,
Defendants.

OPINION AND ORDER

In this civil action for monetary and injunctive relief, plaintiff Kimberly-Clark Corporation contends that defendants Tyco International (US), Inc., The Kendall Company, Inbrand Corporation, and Confab, Inc., are infringing the claims of three patents plaintiff owns on the design of diapers: U.S. Patent No. 4,704,116 (Enloe I), U.S. Patent No. 5,415,644 (Enloe II), and U.S. Patent No. 5,599,338 (Enloe III). Jurisdiction is present. 28 U.S.C. § 1338(a). Presently before the court are plaintiff's motion for summary judgment of infringement of the claims of the Enloe III patent and defendants' motion for summary judgment of non-infringement of the claims of Enloe I and Enloe II. Because I find that genuine disputes of material fact exist, all of the motions for summary judgment will be denied.

From facts proposed by the parties, I find the following to be relevant and undisputed.

FACTS

Plaintiff is a corporation organized under the laws of Delaware with its principal place of business in Irving, Texas. Defendant Tyco International (US), Inc., is a corporation organized under the laws of Massachusetts with its principal place of business in Exeter, New Hampshire. Defendant Kendall Company was a subsidiary of Tyco. Sometime before plaintiff filed its complaint, defendant Tyco acquired defendant Inbrand and merged it with defendant Kendall. Defendant Kendall has since been renamed the Tyco Healthcare Group LP. Defendant Confab was acquired by Confab Holding Co. and is now doing business as the Kendall-Confab Retail Group, Inc.

This case involves a design development in the diaper industry: the use of stand-up inner flaps. Inner flaps slow the movement of liquid waste along the surface of the diaper's liner, giving the diaper's absorbent core more time to absorb the liquid waste and reducing leakage at the elasticized leg openings. One of plaintiffs employees, Kenneth Enloe, is the named inventor on the three patents at issue in this case: U.S. Patent No. 4,704,116 (Enloe I), U.S. Patent No. 5,415,644 (Enloe II), and U.S. Patent No. 5,599,338 (Enloe III). Plaintiff has been using Enloe's inventions in its Huggies brand diapers since 1989. The flaps are known by a variety of names, including "inner leg cuffs" and "barrier cuffs." The parties use "inner flaps" and "barrier cuffs" synonymously. The accused products are sold under a variety of names.

A barrier cuff has two long edges that run parallel to the longitudinal centerline of a diaper. The upper edge, away from the garment, is called the distal edge. The edge contacting the garment is called the proximal edge. Each barrier cuff also has two short ends that are perpendicular to the cuff's distal and proximal edges. The cuffs may be either a separate piece of material attached to the bodyside liner or may be formed from the bodyside liner. If the cuffs are attached to, rather than made from, the material of the bodyside liner, they may be made of a different material from the bodyside liner. Figure 2 from the Enloe III patent shows the frontal view of a cross-section of a diaper with barrier cuffs:

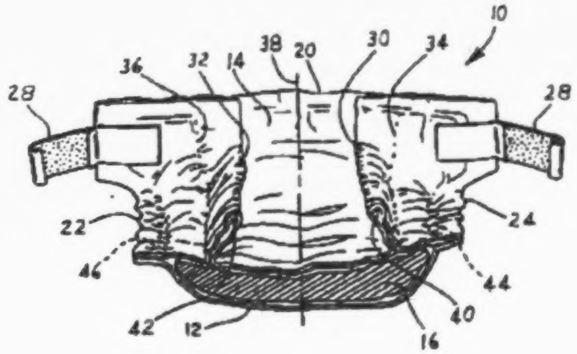

FIG. 2

The inner flaps or barrier cuffs are labeled 30 and 32 and are shaded. The bodyside liner or top surface is labeled 14. The longitudinal centerline is labeled 38. The absorbent core is labeled 16. The gasketing leg cuffs, which are different from the barrier cuffs, are labeled 22 and 24.

Enloe I

All of the asserted claims of the Enloe I patent require that the flaps be "fluid pervious" or "liquid pervious." The terms are synonymous. The parent application of Enloe I, filed in July 1984, recited "two flaps extending toward each end." When the application was rejected as unpatentable over prior art, Enloe amended his claims by specifying the necessity of "fluid permeable" flaps and elastic in the flap and at the leg openings. In allowing the claims, the examiner stated: "The claims as amended recite the necessity of a fluid permeable flap and elastic in the flap as well as at the leg openings. This combination overcomes prior art." Independent claim 1 of the Enloe I patent includes the requirement for "fluid pervious" flaps and a "liquid pervious" bodyside liner. The claims encompass:

An absorbent garment comprising:

> a back sheet;
>
> a liquid pervious bodyside liner, essentially coterminous with said back sheet, defining front and back waist sections and opposed first and second sides connecting said waist section(s), including a pair of leg sections delimited along said sides, each of said leg sections having a tensioned elastic member disposed therealong, forming elasticized leg gathers;
>
> an absorbent body disposed between said liner and back sheet; and
>
> first and second elasticized fluid pervious flaps attached to or formed from said bodyside liner and spaced inwardly of said leg elastic members, respectively, defining a waste containment package.

In *Kimberly-Clark Corp. v. Procter & Gamble Distributing Co.*, No. C89-502WD, 1191 U.S. Dist. LEXIS 19389 (W.D. Wash. 1991), *aff'd in part and vacated in part, Kimberly-Clark Corp. v. Procter &. Gamble Co.*, 973 F.2d 911 (Fed. Cir. 1992), plaintiff sued Procter & Gamble for infringement of the Enloe I patent. The parties agree that Judge Dwyer's construction of the Enloe I claim term, "fluid pervious," in that case should be utilized in this case. Judge Dwyer construed the term "fluid" to mean "urine and liquified or runny BM, the body exudates which diapers are intended to contain." *Id.* at *11. He construed "pervious" to mean "that the diaper material would allow a body exudate to pass or transfer through" during the diaper's "normal use." *Id.*

One possible test of perviousness is the "hydrostatic head" test. In this test, the diaper material is attached to the bottom of a hollow glass tube. Liquid is then added slowly to the tube. The test is stopped when liquid penetrates the diaper material. The pressure required for liquid to pass through the material is determined by calculating the weight of the liquid above the test material at the point of penetration. One of defendants' diaper scientists may have employed the hydrostatic head test while developing the flaps in controversy and determined an approximate dividing line between perviousness and imperviousness, although his work was not relied upon in developing the allegedly infringing products.

The hydrostatic head test is not specified in the Enloe I patent. In fact, nowhere in the patent is any test described to define pervious. Judge Dwyer did not use this test to determine whether Procter & Gamble's inner flaps were fluid pervious. Instead, he relied on the "runoff" test, in which flap material with absorbent material beneath was attached to a solid surface inclined at 10 degrees. Approximately 25 milliliters of synthetic liquid urine was then allowed to run down the inclined flap material. The absorbent material beneath the flap was weighed before and after the test to determine whether any liquid had penetrated the flap material. Finding that little if any liquid had reached the absorbent material, Judge Dwyer held that Procter & Gamble's flaps were impervious to fluid and thus did not infringe the Enloe I patent. That judgment on infringement was later vacated after the parties settled the issue privately. The portions of the judgment relating to the invalidity of certain claims of another patent and whether inequitable conduct occurred in the prosecution of the Enloe I patent remained in effect.

Defendants' expert applied the runoff test to all of the accused products and found that they were even less pervious than the Procter & Gamble flaps that Judge Dwyer had decided did not infringe the Enloe I patent. In addition, defendants' expert examined both the non-infringing Procter & Gamble flaps and defendants' flaps under a microscope. He was able to detect small pores in the Procter & Gamble flaps but not in defendants' flaps.

When fluid is pressured into the flap material rather than allowed to run off without pressure, the fluid is more likely to penetrate the material. Plaintiff alleges that it has performed tests that indicate that defendants' inner flaps are pervious under pressure.

Enloe II

The Enloe II patent requires the presence of inner flaps that have a central portion of the distal edge (the edge furthest from the bodyside liner) directed toward the longitudinal centerline of the garment by virtue of the way in which the inner flaps are attached to the bodyside liner of the diaper. Claim 1 is illustrative of this requirement:

> An integral disposable absorbent article comprising:
>
> a liquid pervious topsheet having a top surface;
>
> * * * * *
>
> a pair of barrier cuffs,
>
> (a) each barrier cuff having a proximal edge and a distal edge;
>
> (b) each barrier cuff being disposed inboard of one of the gasketing cuffs,
>
> (c) at least a portion of each barrier cuff being attached to the top surface, and
>
> (d) a central portion of the distal edge of each barrier cuff being directed, by means of said portions being attached to the top surface, toward the longitudinal centerline of the integral disposable article, between the gasketing cuffs of the integral disposable absorbent article; and
>
> means for tensioning the barrier cuffs, to space a portion of the distal edge of each barrier cuff away from the top surface of the topsheet, whereby a channel is formed by the two barrier cuffs and a portion of the topsheet between the barrier cuffs.

Proposed Claim 89 of the Enloe II patent was rejected by the examiner as unpatentable over Tetsujiro (Japanese Utility Model 41-18359) in view of Karami (U.S. Patent No. 4,527,989) and as being unpatentable over Karami (U.S. Patent No. 4,527,989) in view of Tetsujiro (Japanese Utility Model 41-18359). Eventually, the examiner allowed claim 89 as claim 1 of Enloe II after plaintiff added the language from (c) and (d) above, specifying that at least a portion of the barrier cuffs would be attached to the bodyside liner and that by means of that attachment a central portion of the distal edge of the cuffs would be directed inward:

> (c) at least a portion of each barrier cuff being attached to the top surface, and
>
> (d) a central portion of the distal edge of each barrier cuff being directed, by means of said portions being attached to the top surface, toward the longitudinal centerline of the integral disposable absorbent article, between the gasketing cuffs of the integral disposable absorbent article.

Claim 1 is a modified version of rejected claim 89, which was substantively identical to claim 1 except that it did not include the limitations of (c) and (d).

Claim 12 of the Enloe II patent requires the presence of "adhesive means disposed adjacent each of the ends of the barrier cuffs for securing a portion of each barrier cuff." Thus, claim 12 requires that the inward directionality of the cuffs be achieved by attaching the ends of the inner flaps to the bodyside liner. Claim 12 is dependent upon claim 6, an independent claim with language similar to that quoted above from claim 1. FIG. 7 of the patent shows "alternative embodiments of the garment" where the flaps are "curvilinear." Describing the alternative embodiment displayed in FIG. 7, the inventor states that the ends of the flaps "may be folded or bonded" to the bodyside liner at the "ends of each flap . . . whereby" the edges are directed toward the centerline.

The examiner allowed the Enloe II patent to issue because it specified barrier cuffs directed inward by means of their attachment to the topsheet of the diaper. As the examiner stated in his reasons for allowance:

> Applicant distinguishes over the best prior art of record with an integral disposable absorbent article having barrier cuffs inboard of the leg gasketing cuffs that are directed inwardly towards the longitudinal center of the article by means of their attachment to the top surface of the article [and] that are elasticized which is not shown nor fairly suggested by the best prior art of record.

At least some of defendants' products do not achieve inward directionality by attaching the *ends* of the inner flaps to the bodyside liner. These products have barrier cuffs made from a separate piece of material in the shape of a rectangle that is glued to the bodyside liner by securing only the proximal edge to the bodyside liner. These products do not have the ends of the inner flaps attached to the bodyside liner to direct the central portion of their distal edge toward the longitudinal centerline.

Enloe III

Claim 1 of the Enloe III patent is substantively identical to rejected claim 89 from the Enloe II patent. That is, claim 1 of the Enloe III patent is the same as claim 1 of Enloe II except for limitations (c) and (d) of Enloe II. The same examiner examined the applications for Enloe II and Enloe III. Before accepting claim 1 of Enloe III, the examiner raised concerns that it was substantively identical to claim 1 of Enloe II and thus presented a double patenting problem. However, ultimately he allowed the patent to issue. Claim 1 of the Enloe III patent encompasses:

> 1. An integral disposable absorbent article comprising:
>
> a liquid pervious topsheet having a top surface;

> a backsheet connected to the topsheet;
>
> an absorbent core disposed between the topsheet and the backsheet;
>
> a pair of elastically contractible gasketing cuffs, each disposed adjacent to a longitudinal edge of the absorbent article;
>
> a pair of barrier cuffs,
>
> > (a) each barrier cuff having a proximal edge and a distal edge, and
> >
> > (b) each barrier cuff being disposed inboard of one of the gasketing cuffs; and
>
> means for tensioning the barrier cuffs, to space a portion of the distal edge of each barrier cuff away from the top surface of the topsheet, whereby a channel is formed by the two barrier cuffs and a portion of the topsheet between the barrier cuffs.

When the ends of the inner cuffs are attached to the bodyside liner, the ends of the distal edges of those cuffs are necessarily in contact with the bodyside liner. However, a central portion of the distal edge of the cuffs is spaced away from the liner by means of an elastic that tensions the cuff when the diaper is in use. However, if the cuffs are *not* attached at the ends to the bodyside liner, then the *entire* distal edge of the cuffs is spaced away from the bodyside liner when the diaper is in use. Defendants' inner cuffs are not attached at the ends to the bodyside liner. Thus, the entire distal edge is spaced away from the bodyside liner when the diaper is in use.

Independent claims 6 and 15 of the Enloe III patent state that the elastically contractible gasketing cuffs (numbered 22 and 24 in Figure 2 in the Enloe III patent shown above) that are disposed adjacent each longitudinal edge to the absorbent article must be so disposed "in at least the crotch section." However, independent claims 1, 22, 25, and 26 require only that the gasketing cuffs be adjacent to "a longitudinal edge" of the diaper.

OPINION

Summary judgment is appropriate when there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. *Celotex v. Catrett*, 477 U.S. 317, 322 (1986). When considering a motion for summary judgment, the court must examine the material facts in the light most favorable to the non-moving party. *Sample v. Aldi, Inc.*, 61 F.3d 544, 546 (7th Cir. 1995). A material fact is one whose determination will affect the outcome of a suit and an issue of material fact is genuine if the evidence is such that a reasonable jury could find for the nonmoving party. *Anderson v. Liberty Lobby. Inc.*, 477 U.S. 242, 248 (1986).

Determination of patent infringement is a two-step process. *See Desper Products, Inc. v. QSounds Labs, Inc.*, 157 F.3d 1325, 1332 (Fed. Cir. 1998). First, the court must construe the claim as a matter of law to determine its proper scope and meaning. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996). In doing so, the court must consider the claim language, patent specification and prosecution history. *See id.* The court should consider extrinsic evidence only if necessary. *See id.* Second, the trier of fact compares the properly construed claim to the allegedly infringing product. *See Desper Products*, 157 F.3d at 1332. Summary judgment is appropriate only if the composition of the allegedly infringing product is undisputed so that there is no genuine dispute of material fact. *See id.*

This case can be boiled down to five questions: 1) Are defendants' inner flaps fluid impervious during the normal use of a diaper so as to avoid infringing Enloe I? 2) Does the Enloe II patent encompass only inner flaps that are directed toward the centerline by means of their attachment at the end or does it encompass any design that directs the flaps to the centerline by means of their attachment to the bodyside liner? 3) Does claim 1 of the Enloe III patent encompass only inner flaps where only a portion of the distal edge is spaced away from the bodyside liner or does it encompass inner flaps where the entire distal edge is spaced away from the bodyside liner? 4) Does claim 1 of the Enloe III patent encompass the use of inner flaps that are impervious during the normal use of a diaper? 5) Does claim 1 of Enloe III encompass gasketing cuffs that are adjacent to only a portion of the longitudinal edge? I will address each question in turn.

A. *Are Defendants' Inner Flaps Fluid Impervious During the Normal Use of a Diaper So As To Avoid Infringing Enloe I?*

The Enloe I patent concerned the use of "fluid pervious" flaps inside a diaper that enhanced its capacity for containment and absorption by slowing the sideways movements of liquid material and stopping the sideways movement of solid material. According to the patent, the inner flaps may be a separate piece of material attached to the bodyside liner or they may be formed from the bodyside liner. Claim 1 encompasses:

> first and second elasticized fluid pervious flaps attached to or formed from said bodyside liner and spaced inwardly of said leg elastic members, respectively, defining a waste containment package.

As noted, Judge Dwyer construed the claims of the Enloe I patent, including the term "fluid pervious." *See Kimberly Clark*, 1191 U.S. Dist. LEXIS 19389. The parties agree the Judge Dwyer's claim construction of "fluid pervious" should be utilized, but they disagree about what Judge Dwyer's construction of the claim was and how it should be applied in this case.

Judge Dwyer construed the term "fluid" to mean "urine and liquified or runny BM, the body exudates which diapers are intended to contain." *Id.* at *11. He construed "pervious" to mean "that the diaper material would allow a body exudate to pass or transfer through" during the diaper's "normal use." *Id.* The questions upon which the parties most vigorously disagree are what constitutes the normal use of the diaper and whether defendants' inner flaps are pervious under those conditions.

Plaintiff proposes use of the hydrostatic head test to test perviousness. It argues that this test best replicates the conditions of normal use of a diaper and is commonly used in the diaper industry. Defendants disagree. They note that neither this test nor any other is specified in the Enloe I patent and was not employed by Judge Dwyer to determine whether Procter & Gamble's inner flaps were fluid pervious. Instead, defendants argue, the runoff test is the appropriate one. Defendants' expert applied the runoff test to all the accused products and found that they were even less pervious than the Procter & Gamble flaps that Judge Dwyer decided did not infringe upon the Enloe I patent. In addition, defendants note that their expert's examination revealed small pores in the Procter & Gamble flaps but not in defendants' flaps, indicating that defendants' flaps are even less pervious than the non-infringing Procter & Gamble flaps.

Plaintiff points out that during the normal use of a diaper, pressure may be placed on the flaps by the weight of a sitting baby or adult, making the fluid more likely to penetrate the material. Plaintiff alleges that it has performed tests that indicate that defendants' inner flaps are pervious under such conditions.

With due respect to Judge Dwyer, common sense seems to indicate that the runoff test does not best approximate the normal use of a diaper. It can hardly be argued that it is not within the bounds of normal use for fluids to contact the inner flaps under some amount of pressure, particularly when the diaper wearer is sitting down. Defendants argue that the amount of pressure, [sic] encountered varies widely depending upon the position and size of the wearer. Undoubtedly this is true, but as long as those positions and sizes are encompassed in the normal use of a diaper, the Enloe I patent covers flaps that are pervious under those conditions. The hydrostatic head test may or may not be the best measure of the pressure flaps encounter in normal use, but it seems certain that whatever test is employed must measure the range of pressure. What that range of pressure might be, which test best simulates normal use and whether defendants' flaps are pervious under such conditions cannot be resolved at this stage, but must await the *Markman* hearing. Therefore, defendants' motion for summary judgment as to its infringement of the Enloe I patent will be denied.

Defendants make much of the fact that the Enloe I patent states for each claim that the flaps may be formed from the bodyside liner and made from the same material as the bodyside liner. They note that if the entire bodyside liner were pervious only under pressure, the diaper would be functionally inoperable: any time a baby was standing or otherwise not exerting pressure on the diaper, fluids could not penetrate the bodyside liner to reach the absorbent core and would leak out instead. Therefore, they argue, because the inventor contemplated flaps made from the bodyside liner, he must have contemplated flaps that are pervious regardless whether the fluids are subject to pressure. However, defendants ignore the fact that claim 1 contemplated that the flaps may be formed from "or attached to" the bodyside liner. Thus claim 1 covers flaps made from the bodyside liner as only one possibility; it also covers flaps that are attached to the bodyside liner. Although logic dictates that flaps *made from* the bodyside liner must be pervious even without pressure, it does not compel a similar conclusion for flaps that are *attached to* the bodyside liner. Such flaps could be made from a different material that is pervious only under some amount of pressure.

Defendants also argue that plaintiff's construction of the Enloe I patent would render it invalid because the term "fluid pervious" is indefinite. "The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, 33 F.3d 1354, 1360 (Fed. Cir. 1994). This standard is satisfied if "one skilled in the art" would not "have any particular difficulty in determining" whether a given product is covered by the scope of the patent claims. *Id.* at 1361. Defendants argue that use of the vague term "fluid pervious" without any reference to a test for perviousness deprives inventors of the ability to determine the scope of the Enloe I patent. Not necessarily. Those skilled in the diaper art might understand the normal range of pressures to which flaps could be subject and might be able to determine whether their flaps are pervious under those conditions; certainly plaintiff's diaper scientists believe they could do so. There is evidence to suggest that one of defendants' own diaper scientists employed the hydrostatic head test while developing the flaps in controversy and determined an approximate dividing line between perviousness and imperviousness.

Moreover, as a matter of law, plaintiff is not required to "specifically delineate the point at which infringement starts." *Andrew Corp. v. Gabriel Electronics, Inc.*, 847 F.2d 819, 822 (Fed. Cir. 1988). Such a requirement would exclude patents that could not state "the exact point in which a change in the physical phenomenon occurs" and would leave unprotected improvements when change "is by nature gradual or incremental." *Id.* Therefore, a "claim is not fatally indefinite for failing specifically to delineate the point at which change in physical phenomenon occurs." *Id.* That the dividing line between perviousness and imperviousness may be inexact and "experimentation may be needed" to discover what is within and outside the patent does not necessarily render the patent void for indefiniteness. Rather, the imprecision of plaintiff's claim is "to be considered in determination of infringement." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 842 F.2d 1275, 1280 (Fed. Cir. 1988). Whether defendants' flaps infringe the Enloe I patent depends upon the range of pressure flaps encounter in normal use and whether defendants' flaps are pervious under those conditions. These questions cannot be resolved on this motion for summary judgment. The first will be resolved at the *Markman* hearing; the second must await trial.

B. *Does the Enloe II Patent Encompass Only Inner Flaps That Are Directed Toward the Centerline by Means of Their Attachment at the End or Does It Encompass Any Design That Directs the Flaps to the Centerline by Means of Their Attachment to the Bodyside Liner?*

The claims of the Enloe II patent require the presence of inner flaps that have a central portion of the outer edge directed toward the longitudinal centerline of the garment by virtue of the way in which the inner flaps are attached to the bodyside liner of the diaper. Claim 1 is illustrative of this requirement:

> An integral disposable absorbent article comprising:
>
> a liquid pervious topsheet having a top surface;
>
> * * * * *
>
> a pair of barrier cuffs,
>
> (a) each barrier cuff having a proximal edge and a distal edge;
>
> (b) each barrier cuff being disposed inboard of one of the gasketing cuffs;
>
> (c) at least a portion of each barrier cuff being attached to the top surface; and
>
> (d) a central portion of the distal edge of each barrier cuff being directed, by means of said portions being attached to the top surface, toward the longitudinal centerline of the integral disposable article . . . .

When the elasticized outer edge of the inner flap stands up in use, the attachment of the two ends causes the portion of the outer edge to be directed inwardly. Claim 12 of the Enloe II patent requires the presence of "adhesive means disposed adjacent each of the ends of the barrier cuffs for securing a portion of each barrier cuff." Thus, claim 12 requires that the inward directionality of the cuffs be achieved by attaching the ends of the inner flaps to the bodyside liner. Claim 12 is dependent upon claim 6, an independent claim with language similar to that quoted above from claim 1. Unlike dependent claim 12, independent claims 1 and 6 do not specify that the cuffs be attached at the ends. Rather, they state that "at least a portion" must be attached and that the attachment produce inward directionality.

Defendants have moved for summary judgment, arguing that they have not infringed the Enloe II patent because their allegedly infringing products do not achieve inward directionality by attaching the *ends* of the inner flaps to the bodyside liner. These products have barrier cuffs made from a separate piece of material in the shape of a rectangle that is glued to the bodyside liner by securing only the proximal edge to the bodyside liner. Thus, these products do not have the ends of the inner flaps attached to the bodyside liner to direct the central portion of their distal edge toward the longitudinal centerline. In fact, defendants assert, the allegedly infringing flaps are not directed inward at all.

Patent claims are not usually limited to the preferred embodiment described in the specification. *See Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855 (Fed. Cir. 1988) ("references to a preferred embodiment, such as those often present in a specification, are not claims limitations"). Moreover, "where some claims are broad and others narrow, the narrow claim limitations cannot be read into the broad." *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 770 (Fed. Cir. 1983). Therefore, although the preferred embodiment of the Enloe II patent is a design with the *ends* of the flaps attached to the bodyside liner to achieve inward directionality and although dependent claim 12 describes flaps attached in that manner to achieve that result, the patent is not limited to that embodiment. Because independent claims 1 and 6 broadly cover flaps where "a portion" is attached to the topsheet and the flaps are directed inward by means of that attachment, the scope of the patent is not limited to flaps attached at their ends.

Plaintiff points out that FIG. 7 of the patent shows "alternative embodiments of the garment" where the flaps are "curvilinear" and argues that through this design the flaps achieve inward directionality by the attachment to the bodyside liner along a curved line rather than by attachment at the ends. Defendants insist that *every* embodiment in Enloe II has the ends of the flaps attached to the bodyside liner, including the alternative embodiment displayed in FIG. 7, which states that the ends of flaps "may be folded or bonded" to the bodyside liner at the "ends of each flap . . . whereby" the edges are directed toward the centerline. Defendants' argument ignores the word "may" in the quotation above, which suggests that although attachment at the ends is one possibility to achieve inward directionality, there are other possibilities as well. Claim 1 is limited to cuffs that are directed inward because of their attachment to the bodyside liner. The attachment "may" occur at the ends or it "may" occur elsewhere. It is true, as defendants argue, that the Enloe II patent was issued only after a long struggle and only because it specified barrier cuffs directed inward by means of their attachment to the topsheet of the diaper. As the examiner stated in his reasons for allowance:

> Applicant distinguishes over the best prior art of record with an integral disposable absorbent article having barrier cuffs inboard of the leg gasketing cuffs that are directed inwardly towards the longitudinal center of the article by means of their attachment to the top surface of

> the article [and] that are elasticized which is not shown nor fairly suggested by the best prior art of record.

However, like the patent itself, the examiner did not specify that the attachment that causes inward directionality must occur at the ends of the flaps. Instead, by its plain language claim 1 encompasses any flap that achieves inward directionality by means of its attachment to the top surface of the diaper. Thus, if defendants' inner flaps are directed inward because of the way in which they are attached to the bodyside liner, they infringe the Enloe II patent regardless whether the attachment is at the ends of the flaps.

There is a dispute of fact whether the allegedly infringing flaps are directed inward that cannot be resolved on these motions for summary judgment. However, defendants argue that even if the allegedly infringing flaps are directed inward and even if the Enloe II patent covers all inner flaps that are directed inward because of their attachment to the bodyside liner, the flaps on their diapers do not come within the patent's purview. Defendants contend that plaintiff's expert Mary Jordan admits that defendants' inner flaps are directed inward by elastics, not by attachment to the bodyside liner; thus, defendants conclude, their flaps cannot infringe Enloe II. Although defendants' interpretation of Jordan's testimony is reasonable, it is not exclusive. Another reasonable interpretation of the testimony is that it is the attachment of the elastic within the flaps to the bodyside liner that produces inward directionality, a design arguably encompassed by the patent. I conclude that whether the use of elastics moves defendants' flaps outside the range of Enloe II is a disputed question of material fact that cannot be resolved at summary judgment.

Finally, defendants argue that even if plaintiff's curved flaps do not achieve inward directionality by the attachment of the ends to the bodyside liner, they "cannot function like" defendants' admittedly rectangular flaps and therefore the patent does not cover rectangular flaps. I understand defendants to be arguing that even if their flaps are encompassed in all other respects by the Enloe II patent, they cannot infringe because of their rectangular shape. This argument is unpersuasive. The Enloe II patent encompasses flaps directed inward by means of their attachment to the bodyside liner; whether the flaps are curved or rectangular is immaterial as long as the flaps are directed inward by means of their attachment to the bodyside liner. Whether defendants' rectangular flaps are directed inward by means of their attachment to the bodyside liner is an issue for the trier of fact.

C. *Does the Enloe III Patent Encompass Only Inner Flaps That Space Only a Portion of the Distal Edge Away from the Bodyside Liner Or Does It Also Encompass Inner Flaps That Space the Entire Distal Edge Away from the Bodyside Liner?*

Plaintiff has moved for summary judgment as to defendants' infringement of Enloe III. Defendants have not moved for summary judgment on this claim, but invite the court to use its inherent power, *see Goldstein v. Fidelity and Guaranty Ins. Underwriters, Inc.*, 86 F.3d 749, 750 (7th Cir. 1996), to grant them summary judgment of non-infringement if the court adopts their claim construction. Alternatively, defendants invite the court to find that the Enloe III patent is invalid for obviousness if the court adopts plaintiff's claim construction. Because I find that disputed issues of material fact prevent the adoption of either party's construction, plaintiff's motion will be denied and defendants' invitation will be declined.

Claim I of Enloe III provides for "means for tensioning the barrier cuffs, to space a portion of the distal edge of each barrier cuff away from the top surface of the topsheet." Plaintiff argues that because defendants' flaps space the entire distal edge away from the bodyside liner, they necessarily space "a portion" of the flaps away and therefore literally infringe Enloe III. Defendants contend that the Enloe III patent encompasses inner flaps that space *only* a portion of the distal edge away from the bodyside liner. This argument is closely related to the argument regarding whether the Enloe II patent requires that the ends of the flaps be attached to the bodyside liner (discussed above). When the ends of the inner cuffs are attached to the bodyside liner, the ends of the distal edge are necessarily in contact with the bodyside liner. However, a central portion of the distal edge of the cuffs is spaced away from the liner by means of an elastic that tensions the cuff when the diaper is in use. In other words, when the ends of the cuffs are attached to the bodyside liner, so are the ends of the distal edge; but the center of the distal edge stands up away from the bodyside liner when the diaper is in use. However, if the cuffs are *not* attached at the ends to the bodyside liner, then the *entire* distal edge of the cuffs is spaced away from the bodyside liner when the diaper is being worn. Because defendants' inner cuffs are not attached at the ends to the bodyside liner, the entire distal edge is spaced away from the bodyside liner when the diaper is in use.

In arguing that "to space a portion" must mean to space *only* a portion, defendants rest on their belief that the Enloe III patent is like the Enloe II patent in requiring that the ends of the flaps be attached to the bodyside liner. Defendants argue that the language they believe requires the ends to be attached to the bodyside liner is the same in both the Enloe II and Enloe III patents and that the language should be interpreted consistently. If attachment at the ends is required, then *only* a portion of the distal edge is spaced away from the bodyside liner. Cuffs unattached at the ends, such as defendants', are freestanding and thus have their *entire* distal edges spaced away from the bodyside liner. I have already explained that the Enloe II patent covers any cuffs that are directed inward by means of their attachment to the top surface, regardless whether such attachment is at the end of the cuffs. I agree with defendants that the same language in Enloe II and Enloe III should be interpreted in the same manner. Therefore, I conclude there is no merit to defendants' contention that the Enloe III language "to space a portion of the distal edge of each barrier cuff away from the top surface of the topsheet" must mean *only* a portion because the ends of the flaps (and thus the distal edges) must be attached to the bodyside liner.

In their *Markman* brief, defendants offer a second and more persuasive argument why "to space a portion" must mean *only* a portion. They contend that claim 1 in the Enloe III patent is substantively identical to claim 89 of the Enloe II patent, which the examiner rejected as unpatentable over prior art. Eventually, the examiner allowed claim 89 to issue as claim 1 of Enloe II after plaintiff added the following language specifying that at least a portion of the barrier cuffs would be attached to the bodyside liner and that by means of that attachment a central portion of the distal edge of the cuffs would be directed inward:

> (c) at least a portion of each barrier cuff being attached to the top surface, and
>
> (d) a central portion of the distal edge of each barrier cuff being directed, by means of said portions being attached to the top surface, toward the longitudinal centerline of the integral disposable absorbent article, between the gasketing cuffs of the integral disposable absorbent article.

The claim also requires "means for tensioning the barrier cuffs, to space a portion of each barrier cuff away from the surface of the topsheet." I agree with defendants that the combined effect of these limitations is that at least a portion of the cuff is attached to the bodyside liner and a portion (and thus *only* a portion) is spaced away from it. Like claim 1 of Enloe II, claim 1 of Enloe III also requires "means for tensioning the barrier cuffs, to space a portion of each barrier cuff away from the surface of the topsheet", but unlike claim 1 of Enloe II (and exactly like rejected claim 89 of Enloe II), claim 1 of Enloe III does not include the requirements of (c) and (d), quoted above, that at least a portion of each be attached to the top surface of the bodyliner.

Defendants argue that claim 1 of Enloe III must be interpreted in the same manner as claim 1 of Enloe II, that is, that a portion of the distal edge is attached to the liner so *only* a portion can be spaced away. They contend that because claim 1 of Enloe III is substantively equivalent to rejected claim 89 of Enloe II, the examiner must have read into claim 1 of Enloe III the same limitations he required of claim 89 before allowing it to issue as claim 1 of Enloe II. Those limitations appear at (c) and (d) of claim 1 of Enloe II. Therefore, defendants argue, the court should do what they contend the examiner must have done: read limitations (c) and (d) from claim 1 of Enloe II into claim 1 of Enloe III. Doing so would compel the conclusion that (just as in Enloe II) the words "to space a portion of each barrier cuff away from the topsheet" in Enloe III must mean to space *only* a portion. In support of this argument, defendants note that the examiner thought the scope of claim 1 of Enloe II and claim 1 of Enloe III was so similar that it raised a double patenting problem. This could be so only if the examiner read into claim 1 of Enloe III the same limitations (c) and (d) as exist in claim 1 of Enloe II.

It is true that to read "a portion" as encompassing the entire distal edge seems to read a limitation out of claim 1 of Enloe III. After all, if plaintiff had wanted to include not only "a portion" of the distal edge but also the entire edge within the scope of the patent, it could have chosen the words "*at least* a portion," as it did in limitation (c) of claim 1 of Enloe II. However, defendants' arguments seem equally flawed. Although it is possible that the best explanation why the substantive equivalent of rejected claim 89 was accepted as claim 1 of Enloe III is that the accepted claim was interpreted by the examiner in the same manner as accepted version of claim 1 of Enloe II, that explanation has its problems. First, it reads into claim 1 of Enloe III limitations (c) and (d) of Enloe II. Defendants cite no support for the proposition that reading limitations from a more limited patent into a facially broader patent is appropriate. This is hardly surprising: the canons of claims construction teach the opposite. *See Kalman*, 713 F.2d at 770 ("where some claims are broad and others narrow, the narrow claim limitations cannot be read into the broad").

Second, defendants do not explain why, if the examiner interpreted claim 1 of Enloe II and claim 1 of Enloe III identically, claim 1 of Enloe III was not rejected for double patenting. Reading limitations (c) and (d) from claim 1 of Enloe II into claim 1 of Enloe III would raise the same double patenting problem for the court that the examiner faced initially. In other words, reading into claim 1 of Enloe III the same limitations as claim 1 of Enloe II has the potential of rendering Enloe III invalid. This would contravene the precept that patents are entitied to a presumption of validity and courts should not read into them limitations that would render them invalid. *See Becton Dickinson and Co. v. C.R. Bard, Inc.*, 922 F.2d 792 (Fed. Cir. 1990); *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1096 (Fed. Cir. 1985), *vacated and remanded on other grounds*, 475 U.S. 809 (1986); *see also* 35 U.S.C. § 282 ("A patent shall be presumed valid . . . .").

Finally, if the allowance of claim 1 of Enloe III cannot be interpreted consistently with the rejection of claim 89 of Enloe II, perhaps the acceptance of claim 1 of Enloe III represents the better and truer decision. As defendants note, the same examiner examined the proposed claims of both Enloe II and Enloe III. Perhaps the acceptance of claim 1 of Enloe III represents the better rule because the decision was rendered at a later date by the same examiner. Certainly defendants offer no support for their assertion that they are entitled to a presumption that rejection of claim 89 is correct if it is substantively identical to allowed claim 1 of Enloe III. Indeed, the presumption of validity to which Enloe III is entitled counsels the opposite result. Therefore, the best construction of the claim is that it encompasses not only flaps in which only a portion the distal edge is spaced away from the top surface, but also flaps in which the entire distal edge (and thus also a portion) is spaced away.

D. *Does Claim 1 of the Enloe III Patent Encompass the Use of Impervious Inner Flaps?*

I understand plaintiff to concede that neither the Enloe I nor Enloe II patent encompasses the use of fluid impervious flaps. However, plaintiff contends that claim 1 of the Enloe III patent does encompass the use of flaps that are fluid impervious during normal use. Claim 1 of Enloe III describes only "a pair of barrier cuffs"; unlike Enloe I or II, the claim says nothing about the cuffs' perviousness. In the "background art" section of the patent, the inventor explains that prior art, including "waterproof" flaps, is problematic, and notes that "the present application teaches an improved disposable garment which provides fluid pervious flaps." Were that the only reference in the patent to the perviousness of the flaps, the issue would be settled in defendants' favor. However, in explaining the modes for carrying out the invention, the patent teaches that "the preferred material" for the flaps "is a liquid pervious material."

Plaintiff argues that because liquid pervious flaps are the "preferred" embodiment, liquid impervious flaps must be the non-preferred embodiment. Preferred embodiments generally do not limit the scope of a patent. *See Laitram Corp.*, 863 F.2d at 855. Plaintiff contends that reading perviousness into claim 1 of Enloe III improperly reads out the specification that liquid pervious flaps are only "preferred." *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) ("First, we look to the words of the claims themselves, both asserted and nonasserted, to define the scope of the patented invention."). Obviously, for one embodiment to be preferred, another embodiment within the contemplation of the inventor must be non-preferred. The only non-preferred embodiment of "liquid pervious" flaps must be liquid impervious flaps. Plaintiff argues that because liquid impervious flaps were within the contemplation of the inventor, as evidenced by the reference to preferred pervious flaps in the specification, they are within the scope of the patent.

Defendants argue that the prosecution histories of Enloe I and Enloe II demonstrate that plaintiff's attempts to claim liquid impervious flaps were rejected by the claims examiner as unpatentable over prior art. For example, the parent application of Enloe I filed in July, 1984, contained a broad claim reciting "two flaps extending toward each end." The application was rejected as unpatentable over prior art. Enloe then amended his claims in at least two ways: he specified the necessity of "fluid permeable" flaps and elastic in the flaps and at the leg openings. In his reasons for allowance, the examiner stated, "The claims as amended recite the necessity of a fluid permeable flap and elastic in the flap as well as at the leg openings. This combination overcomes prior art." Relying on *I.O. Corp. v. Tekmar Co., Inc.*, 115 F.3d 1576 (Fed. Cir. 1997), defendants argue that the limitations of Enloe I and Enloe II to fluid pervious cuffs should be read into the generic reference to "barrier cuffs" in Enloe III. In *Tekmar*, the Federal Circuit ruled that the generic term "passage" could only mean structures that were non-smooth or conical because prior art covered passages that were smooth and cyndrical. Similarly, defendants argue, the prosecution histories of Enloe I and II indicate that prior art covered fluid impervious flaps, so the generic term "barrier cuffs" in Enloe III can mean only fluid pervious barrier cuffs.

Plaintiff is correct that, in general, claims of a patent are not limited by preferred embodiments. *See CVI/Beta*

Industries, Inc. v. Tura LP, 112 F.3d 1146, 1158 (Fed. Cir. 1997). However, statements made during the prosecution or reexamination of a patent may commit the patent holder to a particular meaning for a patent term that is then binding in litigation. *See id.* In this case, it seems clear that plaintiff committed itself to fluid pervious flaps in the prosecution of Enloe I. It is well established that the prosecution of a parent application is relevant to the scope of the claim in subsequent related applications. *See Jonsson v. The Stanley Works*, 903 F.2d 812, 818 (Fed. Cir. 1990). Further, even in the "background art" section of Enloe III, the inventor explains that the patent's distinction from prior art is that "the present application teaches an improved disposable garment which provides fluid pervious flaps." The only reference to impervious flaps is by negative implication from the statement that pervious flaps are preferred. The negative implication to be drawn from the preference for fluid pervious flaps is simply insufficient to overcome the prosecution history of Enloe I and the background art section of Enloe III itself.

In addition, although it is true that the specification in Enloe III states that "the preferred material" for the flaps "is a liquid pervious material," exactly the same language can be found in Enloe I. *See* Col. 4, ll. 60-61. Plaintiff does not explain why it concedes that Enloe I does not encompass fluid impervious flaps while asserting that Enloe III does, when it used the same language in both patents. Presumably, plaintiff makes this claim because claim 1 of Enloe III recites generic "barrier cuffs" rather than the "fluid pervious flaps" found in claim 1 of Enloe I. However, the use of the generic term "barrier cuffs" in Enloe III does not overcome the prosecution history of Enloe I or the fact that Enloe III itself states that its use of fluid pervious cuffs is an improvement over prior art. Like Enloe I and Enloe II, Enloe III does not cover flaps that are impervious during the normal use of the diaper.

E. *Does Claim 1 of Enloe III Encompass Gasketing Cuffs That Are Adjacent to Only a Portion of the Longitudinal Edge?*

Claim 1 of Enloe III specifies "a pair of elastically contractible gasketing cuffs, each disposed adjacent to a longitudinal edge of the absorbent article." Similar language is found in independent claims 22, 25 and 26. However, independent claims 6 and 15 specify that the gasketing cuffs "are disposed adjacent each longitudinal edge to the absorbent article *in at least the crotch section.*" Plaintiff maintains that defendants' Toyo Belt-Free Disposable product infringes Enloe III because a portion of the elastic gasketing cuffs in that product is adjacent to its longitudinal edge. It is unclear from the pleadings whether plaintiff believes other products manufactured by defendant also infringe this claim.

Defendants argue that the patent requires that the gasketing cuff remain adjacent to the edge and, in particular, that it be adjacent in at least the crotch section. They contend that gasketing cuffs that run away from the longitudinal edge through the crotch section are not within the scope of the claim. They conclude that because only a portion of the gasketing cuff of the Toyo Belt-Free Disposable product is adjacent to the longitudinal edge and not in the crotch section where the cuff runs away from the longitudinal edge, this product does fall within the scope of the patent.

The claim language does not require that the gasketing cuff be adjacent to the entire edge of the product. To so interpret the claim would read the limiting word "entire" into it. Reading extraneous limitations into the claim is improper. *See Hoganas AB. v. Dresser Industries; Inc.*, 9 F.3d 948 (Fed. Cir. 1993). Defendants' product is not saved from a finding of infringement simply because only a portion of the gasketing cuff runs adjacent to the longitudinal edge. Moreover, although independent claims 6 and 15 require that the gasketing cuffs be adjacent to the longitudinal edge in "at least the crotch section," independent claims 1, 22, 25, and 26 do not. Those claims simply state that the gasketing cuffs be adjacent to "a longitudinal edge" of the diaper. Again, "where some claims are broad and others narrow, the narrow claim limitations cannot be read into the broad." *See Kalman*, 713 F.2d at 770. Therefore, the Enloe III patent covers gasketing cuffs that are adjacent to a longitudinal edge of the diaper, regardless whether the gasketing cuffs are adjacent along the entire edge or in the crotch section.

It is unclear from the pleadings whether the gasketing cuffs of the Toyo Belt-Free Disposable product are adjacent to the longitudinal edge of the diaper, thereby infringing the claims of Enloe III. Moreover, it is unclear from the pleadings which of defendants' other products are alleged to have gasketing cuffs adjacent to a longitudinal edge. The issue will be settled at trial according to the construction of the clalm described above.

F. *Conclusion*

Defendants' motion for summary judgment as to their products' noninfringement of the claims of U.S. Patent No. 4,704,116 (Enloe I) will be denied. Whether defendants' products infringe the claims of that patent depends upon what range of pressures are part of the normal use of a diaper and whether defendants' inner flaps are fluid pervious under those conditions. The first question will be resolved at the *Markman* hearing; the second must await trial. Defendants' motion for summary judgment as to its noninfringement of the claims of U.S. Patent No. 5,415,644 (Enloe II) will be denied also. That patent encompasses any flap that achieves inward directionality by means of its attachment to the top surface of the diaper. Whether defendants' flaps are directed inward by means of their attachment to the bodyside liner is an issue for the trier of fact. Plaintiff's motion for summary judgment as to defendants' infringement of the claims of U.S.

Patent No. 5,599,338 (Enloe III) will be denied. That patent does not encompass inner flaps that are fluid impervious during the normal use of a diaper, but does encompass the use of barrier cuffs that have their entire distal edges spaced away from the bodyside liner and gasketing cuffs that are adjacent to a longitudinal edge of the diaper. On the present record, I cannot determine whether any of defendants' products have gasketing cuffs adjacent to a longitudinal edge of the diaper. Because I adopt neither party's construction of the claims of Enloe III, defendants' invitation to grant them summary judgment on the basis of noninfringement or invalidity for obviousness must be declined.

ORDER

IT IS ORDERED that:

1. The motion for summary judgment of defendants Tyco International (US), Inc., The Kendall Company, Inbrand Corporation, and Confab, Inc. as to its noninfringement of the claims of U.S. Patent No. 4,704,116 (Enloe I) and U.S. Patent No. 5,415,644 (Enloe II) is DENIED; and

2. Plaintiff Kimberly-Clark Corporation's motion for summary judgment as to defendants' infringement of the claims of U.S. Patent No. 5, 599,338 (Enloe III) is DENIED.

Entered this 9th day of September, 1999.

BY THE COURT:

/s/ Barbara B. Crabb
BARBARA B. CRABB
District Judge

APPENDIX E

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

[Filed Apr. 20, 2001]

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the APPELLANT, and a response thereto having been invited by the court and filed by the APPELLEES, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on April 27, 2001.

Circuit Judge SCHALL did not participate in the vote.

FOR THE COURT,

/s/ Jan Horbaly
JAN HORBALY
Clerk

Dated: April 20, 2001

cc: V. Bryan Medlock, Jr.
John M. Skenyon

KIMBERLY-CLARK V TYCO INTL, 00-1080
(DCT - 98-CV-0756)

Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

②

Supreme Court, U.S.
FILED
AUG 7 2001
OFFICE OF THE CLERK

No. 01-95

IN THE

Supreme Court of the United States

KIMBERLY-CLARK CORPORATION,

Petitioner,

v.

TYCO INTERNATIONAL (US), INC.,
THE KENDALL COMPANY, INBRAND CORPORATION,
and CONFAB, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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COUNTERSTATEMENT OF THE QUESTIONS PRESENTED

1. Whether an opinion of the Court of Appeals for the Federal Circuit, which has been designated as nonprecedential by that Court, can be cited and followed as precedent in future cases.

2. Whether the district court and the Court of Appeals for the Federal Circuit erred when they followed established law and interpreted the claims of the patents-in-suit as excluding the prior art disclaimed by the applicant during prosecution of the patent applications, which resulted in the issuance of the patents-in-suit.

STATEMENT PURSUANT TO RULE 29.6

Respondents, The Kendall Company and Inbrand Corporation, are wholly owned by Respondent Tyco International (US), Inc. Respondent, Tyco International (US), Inc., is wholly owned by The Tyco International Ltd. which is a publicly held company.

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The Respondents respectfully request that this Court deny the petition for a writ of certiorari. The decision below is not in conflict with any decisions of this Court or of the Federal Circuit. Instead, it follows the long-established law of interpreting patent claims to exclude prior art that the patent applicant has distinguished and disclaimed during the prosecution of its patent application. In addition, contrary to the Petitioner's assertion, the opinion below does not create a new methodology of claim construction rendering that task unpredictable in future patent cases. In fact, the Federal Circuit expressly designated its opinion as nonprecedential under its Rule 47.6(b), which precludes the opinion from being cited as precedent in any other case.

INTRODUCTION

The petition here not only omits key facts relied upon by both the district court and the Federal Circuit in reaching their decisions, but it also mischaracterizes the Federal Circuit's treatment of the claim construction issue, which the Petitioner erroneously describes as an arbitrary reading of a limitation from the patent specification into the claims. In reality, the "limitation" in question is prior art which the Petitioner expressly disclaimed early on in the lengthy prosecution of the patents-in-suit. In properly construing the claims at issue, the Federal Circuit below followed the previous decisions of both this Court and the Federal Circuit, which make it clear that when a patent applicant disclaims subject matter during the prosecution of its patent application, it cannot later "recapture" the disclaimed subject matter for the purposes of proving infringement in a litigation.

RESTATEMENT OF THE CASE

A. Kimberly-Clark Disclaimed Fluid Impervious Flaps In the Prosecution Of Its Enloe Patents

The case below involved three patents ("the Enloe patents"), all based on a common parent application and all having a common prosecution history. The invention covered by the claims of all three Enloe patents is a diaper with flaps, which flaps are intended to trap solid or partially solid bodily waste so that it does not leak out the sides of the diaper (JA 95, col. 1, lines 16-21; col. 4, lines 63-67; JA 4, 91).[1] There are two types of diaper flaps: fluid pervious ones and fluid impervious ones.

The original Enloe patent application was filed on July 2, 1984, and its broadest claim covered both types of flaps (App. 2-3a).[2] However, in the very first Office Action, the Examiner rejected the broadest claim as being anticipated by the prior art Beckestrom patent, which disclosed a diaper with fluid impervious flaps. As the Federal Circuit correctly noted below, the Petitioner made absolutely no attempt to argue that this anticipation rejection was incorrect in any way (App. 3a).

Instead, the Petitioner immediately abandoned the original Enloe application and filed the continuation-in-part application which later became the first Enloe patent ("Enloe I") (App. 3a). In order to overcome the Beckestrom prior art with its fluid impervious flaps in the new application, the Petitioner added three paragraphs to the specification. The first described the prior art Beckestrom patent with fluid impervious flaps (JA 6, 16). The second, which immediately followed, explained a problem associated with fluid impervious flaps (App. 3a), and finally, in the third new paragraph, the Petitioner described the Enloe invention as being just *fluid pervious* flaps, which solved the problem created by the fluid impervious flaps of the prior art (App. 3a). The only flap material actually disclosed in the new Enloe I specification was fluid pervious material (App. 4a), and all the new claims submitted by the Petitioner with the new Enloe I application were expressly limited to fluid pervious flaps (App. 4a). Both the district court and the Federal Circuit correctly characterized all this as a disclaimer by the Petitioner of fluid impervious flaps (App. 5a). And the disclaimer was successful. With some other minor amendments, the Examiner then allowed the Enloe I claims, noting that a key to allowance was the limitation of the claims to fluid pervious flaps (JA 6, 2976-7).

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[1] As in the Petition, these citations to "JA" refer to materials found in the Joint Appendix filed in the Federal Circuit appeal.

[2] The reference is to the Appendix filed here as part of the Petition.

The Petitioner does not appear to disagree with the district court's and Federal Circuit's characterization of all this as a disclaimer of fluid impervious flaps, at least for Enloe I (Petition at 17). [3] Rather, the Petitioner contends that it set out to and later recaptured in the related Enloe II and Enloe III applications the fluid impervious flaps it disclaimed in Enloe I. Both the district court and the Federal Circuit, however, correctly concluded that the Petitioner's alleged recapture attempt was largely illusory and entirely unsuccessful.

---

3. The Petitioner refers to lawsuit involving the Enloe I patent and Procter & Gamble (Petition at 8). For much the same reasons, the district court in that case also concluded that the Petitioner had disclaimed fluid impervious flaps in Enloe I (JA 2012-3, 2017-18).

In fact, both the district court and the Federal Circuit found that the Petitioner took affirmative steps to be sure that this disclaimer of the fluid impervious flaps carried over into the continuation applications that became the Enloe II and Enloe III patents in order to ensure the continued successful avoidance of the troublesome prior art Beckestrom patent. In particular, the Petitioner intentionally kept the same three paragraphs added to Enloe I, which paragraphs were successfully used to distinguish Beckestrom in all the subsequent Enloe specifications. As the Federal Circuit said (App. 4a):

> During the prosecution of Enloe II and Enloe III, Enloe never sought to remove or amend that language, nor to traverse, appeal, or submit arguments seeking to overcome the initial rejection [based on Beckestrom] on other grounds.

In fact, aside from one unsuccessful attempt in the Lawson interference discussed below, nowhere in the twelve years of prosecution from the time the Enloe I application was filed in 1985 to the issuance of the Enloe III continuation in 1997 did the Petitioner ever make any attempt to recapture the fluid impervious flaps it had clearly disclaimed in Enloe I (App. 7a).

B. The Patent Office Expressly Excluded Fluid Impervious Flaps From the Lawson Interference

The Enloe II continuation application was filed by the Petitioner in February, 1989 (JA 3535-59), and all of its claims were expressly limited to fluid pervious flaps (JA 3570-5). The Petitioner did not seek to try to "recapture" fluid impervious flaps then. Instead, it described these new fluid pervious flap claims as "more particularly point[ing] out and distinctly claim[ing] applicant's invention" (JA 3575).

On October 20, 1989, the Patent Office declared an interference between the then pending Enloe II application with all its claims limited to fluid pervious flaps and a Procter & Gamble patent to Lawson, which had claims covering both fluid pervious and fluid impervious flaps (JA 3580-82; 2407-2418). An interference determines who is the first inventor of an invention, but the "invention" in dispute is actually defined by the Patent Office in what is called the "count" of the interference. In this interference, the Patent Office defined the count as corresponding to the fluid pervious flap claims of the Enloe II application as well as some claims of the Lawson patent. Notably, the Patent Office specifically *excluded* from the count all the Lawson claims directed to fluid impervious flaps (see JA 3582, 2417-8, Lawson claims 13, 17, 21, 25, 27).[4]

After the interference was declared, the Petitioner amended its claims in Enloe II by copying into its application the claims from the Lawson patent which corresponded to the count (JA 3584-91). These, with later modifications not important here, were to become the issued claims of Enloe II and Enloe III. Unlike the Petitioner's claims, the copied Lawson claims did not specifically refer to the flaps as being fluid pervious. While the Petitioner now insists that these claims of Enloe II (and Enloe III) cover fluid impervious flaps, that is not what the Petitioner told the Patent Office at that time. On the contrary, the Petitioner immediately recognized that even though the copied Lawson claims corresponding to the count did not use the words fluid pervious in relation to the flaps, these claims did *not* cover fluid impervious flaps. The Petitioner tried to fix that, however. It immediately filed a motion with the Patent Office to amend the count to add Lawson's fluid impervious flap claims to the interference (JA 7473-76). In its motion, the Petitioner admitted that the Lawson claims to fluid impervious flaps were *different* than the claims corresponding to the count, but the fluid impervious flap claims should be included in the interference because they would be *obvious* in view of the claims of the count (JA 7475-6). The Patent Office, however, denied the Petitioner's motion.

---

[4] The Lawson patent uses the term "barrier cuffs" for flaps. The parties have treated the terms as interchangeable in this case.

The Petitioner now says that its motion was denied for reasons "unrelated to whether Enloe's pending application supported a generic claim to diapers with flaps" (Petition at 9), but that is only partially correct. The Patent Office held (JA 8742-52, at 8744-5):

> In the Motion, Enloe requests that claims 13, 17, 21, 25, 27 and 28 of Lawson be designated as corresponding to the count. *These claims call for the [flaps] to be [fluid impervious]. In order to be properly designated as corresponding to the count, these claims must be to the same invention (35 USC 102) as the count or obvious (35 USC 103) in view of the count* (37 CFR 1.601(n) and 1.637(c)(3)(ii)). Since these claims were not designated as corresponding to the count on declaration of the interference the burden is on Enloe to show that they are for the same patentable invention as the count. ***The claims are not anticipated by the count*** *and Enloe has made no*

> *attempt to show that the subject matter of these claims would have been obvious from the subject matter of the count or that subject matter in view of other prior art.*

In sum, even though the claims of the count copied by the Petitioner from the Lawson patent did not refer specifically to the flaps as being fluid pervious, those claims, as the Patent Office defined them for the interference and as the Petitioner recognized at the time, did *not* cover fluid impervious flaps. The Petitioner never raised the Patent Office's interpretation of the count as excluding fluid pervious flaps at final hearing in the interference, and it never appealed this adverse ruling. Thus, when the Petitioner won the right to prosecute claims corresponding to the count of the interference (JA 12108), it only won the right to further prosecute claims corresponding to the count as defined by the Patent Office, and that clearly *excluded* claims to fluid impervious flaps, as the Federal Circuit correctly ruled (App. 7a):

> Although Enloe originally specified "fluid pervious" flaps in the application that became Enloe II, he deleted the reference in the claims to "fluid pervious" flaps at the time of the interference in order to copy the claims of the Lawson patent. There is no suggestion in the prosecution history that the deletion of that language had the effect of recapturing fluid impervious flaps.
>
> Indeed, the exclusion of Lawson's fluid impervious claims from the interference, and the denial of Enloe's motion seeking to add those

claims, indicates that the examiner and the Board of Patent Appeals and Interferences understood that Enloe had disclaimed fluid impervious flaps notwithstanding the omission of the express references to fluid pervious flaps.

Subsequently, the only reason the claims in Enloe II and Enloe III do not expressly call for the flaps to be fluid pervious is because they are based upon the Lawson claims the Petitioner copied. And as the Patent Office, Procter & Gamble and the Petitioner all agreed at that time, those claims did not cover fluid impervious flaps.

In terms of the entire Enloe prosecution, the Petitioner continually and repeatedly disclosed fluid impervious flaps as prior art, which it overcame in each Enloe application, including Enloe II and Enloe III, by first adding to and always keeping in its patent specifications the language that described the Enloe invention as being limited to fluid pervious flaps. The Patent Office was of the same opinion in the interference. The Petitioner's current position, however, is as if it had removed this language from the specifications of Enloe II and Enloe III and won its motion to add the fluid impervious claims to the interference count (App. 7a).

C. The Respondents Use Fluid Impervious Flaps

The Respondents also make and sell diapers with flaps, which are fluid impervious flaps and licensed under the Lawson patent, which still kept its fluid impervious flap claims after the interference with Enloe II (JA 1198, 188, 8, 2281-3). The Petitioner, nevertheless, charged the Respondents with infringement of all three Enloe patents.

Thus, the Petitioner's only real attempt to recapture this disclaimed subject matter did not occur in the prosecution of the Enloe patent applications, but rather only in this litigation.

REASONS FOR DENYING THE WRIT

This case does not warrant further review. Although the Petitioner argues that the decision below will dramatically alter the course of patent law, the Federal Circuit's decision was expressly designated as nonprecedential because both the district court and the Federal Circuit followed such well-established law that the opinion does not add to that body of law in any way.

I. The Nonprecedential Federal Circuit Opinion Cannot, As A Matter Of Law, Be Relied Upon In Later Cases

The Petitioner contends that the Federal Circuit "abandoned long-settled principles governing construction of patent claims" (Petition at 3) and in so doing "undermined the certainty and predictability that are essential to the technological innovation and development that the patent laws are designed to promote". (Petition at 4). The Petitioner goes on to argue that the Federal Circuit selectively and arbitrarily read something from the patent specification ("fluid pervious") into the claims of Enloe II and Enloe III, in what the Petitioner erroneously contends is a fundamental change in the rules of claim construction with far reaching affects. According to the Petitioner, (Petition at 13):

> In addition to the impact on future inventions and patents, the court's fundamental changes in the

> rules of claim construction distorts the value of bargains struck in scores of assignments, licensing agreements, and other transactions based upon what were previously understood to be clear and settled patent rights.

The Petitioner then goes on to predict that, as a result of the Federal Circuit's decision here, inventors will undoubtedly minimize any discussion of the preferred embodiment in their patent applications in the future (Petition at 13), which will keep information out of the public domain (Petition at 14).

The first fundamental flaw in this argument is an undisputed fact that the Petitioner neglects to tell this Court. While the Petitioner refers to the Federal Circuit opinion below as "unreported", the Petitioner fails to mention anywhere in its Petition that the decision below was expressly designated as *nonprecedential* by the Federal Circuit under its Rule 47.6(b).[5] That Rule reads:

> (b) **Nonprecedential Opinion and Order.** An opinion or order which is designated as not to be cited as precedent is one unanimously determined by the Federal Circuit issuing it as not adding significantly to the body of law. *Any opinion or order so designated must not be employed or cited as precedent.* This rule does

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[5] The actual opinion of the Federal Circuit in the case bears the legend that "[p]ursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. This disposition will appear in tables published periodically". This legend has been redacted from the first page of the opinion as it is reproduced in the Petitioner's Appendix.

> not preclude assertion of claim preclusion, issue preclusion, judicial estoppel, law of the case, or the like based on a decision of the court designated as nonprecedential.[6]

Neither party requested this Federal Circuit's opinion be reissued as precedential, as permitted by Rule 47.6(c) of the Federal Circuit, and the time for so doing has expired. The Federal Circuit, as a whole, did not disagree with the designation of the opinion as nonprecedential, as it not only denied the Petitioner's petition for rehearing and rehearing en banc below, but it designated its denial as nonprecedential as well (App. 69a). Thus, as a matter of law, the writ of certiorari is being sought here in connection with an opinion which cannot be cited or relied upon for any purpose in any other case. Indeed, it cannot be cited even by the Federal Circuit itself in later cases. Nevertheless, the decision followed the established law of this Court and of the Federal Circuit.

II. The Federal Circuit Correctly Cited And Followed Established Claim Construction Law When Interpreting The Enloe Claims

A. The Federal Circuit Did Not Use A New Methodology

According to the Petitioner, the Federal Circuit began its claim analysis with the specification rather than the claims thus demoting claim language to a "secondary place" in a claim construction analysis (Petition at 11, 13). This is not correct. The Federal Circuit reproduced claim 1 of Enloe I at the outset of its opinion (App. 4a), and thereafter, the Court focused on the question of whether or not the word flaps (or its equivalent) in the Enloe II and Enloe III claims should be interpreted as being limited to fluid pervious ones (App. 5a-8a). The claims were never ignored by the Court nor were they treated as secondary. Instead, the Federal Circuit followed the same treatment of them as did the Petitioner in its brief below.

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[6] Unless otherwise noted, it is our emphasis that is added here and throughout.

The Petitioner then contends that the Federal Circuit improperly read a limitation ("fluid pervious") from the specification into the claims of Enloe II and Enloe III. In its Petition, it cites several cases about the general prohibition against reading limitations into claims where there is no disclaimer. For example, the Petitioner cites *Johnson Worldwide Associates, Inc. v. Zebco Corp.*, 175 F.3d 985 (Fed. Cir. 1999) for the proposition that the written description of a patent will not ordinarily narrow the claims. It also cites *In re Paulsen*, 30 F.3d 1475 (Fed. Cir. 1995) and *McCarthy v. Lehigh Valley R.R.*, 160 U.S. 110, 116 (1890) to the same effect.

While these and other cases stand for a general principal relating to claim construction, the black letter law has long been that the patentee is not permitted to disclaim something during prosecution (*e.g.*, fluid impervious flaps) and then (usually when confronted by a competitor practicing that prior art) contend that its patent claims still somehow cover what it disclaimed to get its claims allowed. *See for example*, *Weber Elec. Co. v. Freeman Elec. Co.*, 256 U.S. 668, 677-678 (1921) ("having thus narrowed his claim against rotary movement in order to obtain a patent, the patentee may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments . . ."); *Computing Scale Co. of America v. Automatic Scale Co.*, 204 U.S. 609, 617 (1907) ("it is perfectly well settled in this court by frequent decisions that where an inventor, seeking a broad claim which is rejected, in which rejection he acquiesces, substitutes therefore a narrower claim, he cannot be heard to insist that the construction of the claim allowed shall cover that which has been previously rejected"); *Lehigh Valley Ry. Co. v. Kearney*, 158 U.S. 461, 465 (1895) ("the rule is that where the applicant acquiesces in the rejection of claims by the Patent Office or in a construction which narrows or restricts them . . . the claim must be confined and restricted to the particular device described"); *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U.S. 38, 40 (1893) ("having originally sought broader claims, which were rejected, and having acquiesced in such rejection, and having withdrawn such claims, and substituted therefore this narrower claim, describing a particular or specific lock, as such, neither the patentee nor his assignees can be allowed, under the authorities, to insist upon such construction of the allowed claim as would cover what had been previously rejected"); *Royer v. Coup*, 146 U.S. 524, 532 (1892) ("a patentee cannot successfully contend that his patent shall be construed as if it still contained the claims which were . . . rejected and withdrawn").

This is precisely what the Petitioner did twice. First, it abandoned its original patent application and limited its claims to fluid pervious flaps in the face of the original Beckestrom rejection; secondly, it acquiesced in and did not appeal from the Patent Office's denial of its motion in the interference to add the claims directed to fluid impervious flaps.

The Federal Circuit also follows the same rule of law, and in the opinion below, the Court correctly cited some of those cases, including *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998) and *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1581 (Fed. Cir. 1997), where the specifications of the respective patents similarly disclaimed certain prior art structures, which could not later be recaptured by the patentees in litigation, regardless of otherwise broad claim language. These cases are ignored by the Petitioner. In short, the Federal Circuit followed existing precedent in how it approached the claim construction issue and how it decided the issue.

B. The Reference In The Enloe Specification To Fluid Pervious Material As Preferred Is Not Disclosure Of Fluid Impervious Material

The Petitioner also points to two things considered by both the district court and the Federal Circuit but determined by both courts to be insufficient to erase its disclaimer of fluid impervious flaps. None of the Enloe patent specifications disclose any fluid impervious material for the flaps or even say that the flaps could be made of fluid impervious material. However, the Petitioner notes that the specifications of the Enloe II and Enloe III patents refer to the fluid pervious material for the flaps as being "preferred". According to the Petitioner, this is somehow an affirmative disclosure of fluid impervious flap material for its invention. The Federal Circuit, however, correctly noted that the same "preferred" language appeared in the Enloe I specification where the fluid impervious flaps were clearly disclaimed. The Federal Circuit concluded that the same carry-over use of the word "preferred" in Enloe II and Enloe III could not eliminate the disclaimer (App. 6-7a):

> Because that statement, when made in the Enloe I specification, plainly did not mean that the claims

> of that patent should be read to include fluid pervious flaps, it cannot reasonably be read to have assumed a different meaning when it was carried over into the specifications of Enloe II and Enloe III. *See Abtox, Inc. v. Exitron Corp.*, 131 F.3d 1009, 1010, 46 USPQ2d 1735, 1735-36 (Fed. Cir.), *modifying* 122 F.3d 1019, 43 USPQ2d 1545 (Fed. Cir. 1997) (improper to construe the same term in related patents differently); *Jonsson v. StanleyWorks*, 903 F.2d 812, 818, 14 USPQ2d 1863, 1869 (Fed. Cir. 1990) (construction of the same term in related patent relevant to an understanding of that term in patent at issue).

Thus, the lower court and the Federal Circuit both properly rejected the Petitioner's contention that the Enloe II and Enloe III claims somehow recaptured something that the Petitioner was careful to omit from its specification as part of its effort to avoid the prior art Beckestrom reference.

C. Claim 26 Of Enloe II Was Not Directed To Fluid Pervious Flaps

The Petitioner also notes that at one point during the prosecution of Enloe II, the Patent Examiner indicated the claims might be patentable if the flaps were fluid pervious (JA 3803). However, at that time in the prosecution, the Petitioner's response was silence (JA 3803). It did not disagree and contrary to the statement in the Petition, it did not submit a claim to fluid pervious flaps, as the Federal Circuit found when it examined the wording of claim 26 itself (App. 7-8a). Consequently, the Federal Circuit correctly concluded that not only did the doctrine of claim differentiation not apply, but it could not take precedence anyway in view of the Federal Circuit's established law (App. at 6-7a); *O.I. Corp., supra* at 1582; *Tandon Corp. v. U.S. Int. Trade Commission*, 831 F.2d 1017, 1024 (Fed. Cir. 1987), which law the Petitioner also does not address in its Petition. As a result, the Federal Circuit's decision is consistent with the principles of claim construction established by the law of the Federal Circuit, which apply to the facts of this case.

D. The Federal Circuit Properly Interpreted The Claims Copied As A Result Of The Interference

The Petitioner's last attempt to eliminate the disclaimer of fluid impervious flaps in two of its Enloe specifications is to assert that the Enloe II and Enloe III claims should be interpreted in light of Procter & Gamble's Lawson specification which, of course, did not contain the disclaimer of fluid impervious flaps found in all the Enloe specifications. In fact, the Petitioner maintains that the Federal Circuit's failure to interpret the Enloe II and Enloe III claims as covering fluid impervious flaps in light of the Lawson specification is contrary to the Federal Circuit's holding in *In re Spina*, 975 F.2d 854, 856 (Fed. Cir. 1992) (Petition at 19).

The Petitioner, however, relies on a statement in *In re Spina* that the copied claim is viewed in the "context" of the application from which it is copied and converts that into a new rule of claim construction which requires the copied claim to be interpreted based on the specification from which the claim was copied, regardless of the specification or prosecution history of the application into which the claim is copied. The Federal Circuit in *Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328 (Fed. Cir. 2000), has rejected that strained interpretation of *In re Spina*.

The facts in *Cultor* are very similar to those here. In his specification, the inventor described his invention as a product and a process limited to removal of one type of catalyst from edible polydextrose, thereby disclaiming all other processes involving different types of catalysts. As a result of an interference with a third party's patent (which was not limited to a process of using that single catalyst), Cultor copied claims from the third party's patent and won the right to further prosecute those copied claims. Cultor then argued in litigation that the copied claims in its patent should be interpreted broadly (as in the application from which they came) as covering all types of catalysts. The Federal Circuit rejected Cultor's argument (at 1332):

> The claims were copied by *Cultor* from United States Patent No. 5,091,015, a patent assigned to the Warner-Lambert Co. The PTO declared the interference, which was later settled. Since the claims were copied to provoke an interference, Cultor argues that they should be construed as they would be construed in the patent from which they were copied. *Cultor* cites *In re Spina*, 975 F.2d 854, 858, 24 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1992), in which this court stated: "A claim is not interpreted one way in light of the specification in which it originally was granted, and another way in light of the specification into which it is copied as a proposed interference count." Thus, argues *Cultor*, the term "polydextrose" should be interpreted according to the use of that term in the Warner-Lambert patent.

* * *

> Every patent claim is construed in the context of the specification in which it appears as part of the patent document. When a claim is copied from another patent for interference purposes, it must be supported by the specification of the copier. In *Spina* the application into which the claim was copied was deemed to contain sufficient written description to support the claim, although the structure by which the claimed function was performed was not the same as the structure shown in the specification from which the claim was copied. *The court in Spina did not hold that the copier of a claim for interference purposes thereby acquires the benefit of the descriptive text of the copied patent.*
>
> *The claims to which Cultor demonstrated priority in the interference are construed in light of* ***Cultor's specification****; it becomes irrelevant whether the specific text of the claim was copied from the interfering patent.*

The Federal Circuit then affirmed the district court's ruling that the claims of the Cultor patent were not infringed because of the disclaimer in Cultor's specification which applied to the otherwise broad, copied claims (at 1331). In sum, the Federal Circuit's decision here is not inconsistent with *In re Spina*, but rather, it correctly follows it. The Petitioner's sole response is in footnote 4 of its Petition that this is not a disclaimer case, a contention with which both the district court and the Federal Circuit disagree.

In short, all the Petitioner really disputes here is the conclusion of two courts that it disclaimed fluid impervious flaps in the prosecution of its Enloe patents. If it is a *disclaimer*, the Petitioner does not argue that the decision below was wrong in any way. Instead, the Petitioner insists it is not a disclaimer and the decision below merely involves the arbitrary reading of a limitation from the specification into the claims. The Petitioner then proceeds to attack that faulty premise. This position was properly rejected by the district court, by a panel of the Federal Circuit, and by the Federal Circuit as a whole when it rejected the petition for rehearing en banc.

CONCLUSION

In conclusion, the Federal Circuit's decision is entirely consistent with the decisions of the Federal Circuit and this Court, and the Petition should be denied.

Respectfully submitted,

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No. 01-95

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IN THE

Supreme Court of the United States

KIMBERLY-CLARK CORPORATION,

Petitioner,

v.

TYCO INTERNATIONAL (US), INC.,
THE KENDALL COMPANY, INBRAND CORPORATION,
AND CONFAB, INC.

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITIONER'S REPLY TO RESPONDENTS' BRIEF IN OPPOSITION TO PETITION

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IN THE

Supreme Court of the United States

No. 01-95

KIMBERLY-CLARK CORPORATION,

Petitioner,

v.

TYCO INTERNATIONAL (US), INC.,
THE KENDALL COMPANY, INBRAND CORPORATION,
AND CONFAB, INC.

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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PETITIONER'S REPLY TO RESPONDENTS' BRIEF IN OPPOSITION TO PETITION[1]

Respondents' opposition does not quarrel with the primary and fundamental rule of claim construction that the Federal Circuit abandoned in this case. Thus, the new approach prescribed by the Federal Circuit's opinion is to deny that the language of patent claims controls the scope of the patent and to allow limitations to be read into clear, broad claim language. Nonetheless, the opposition attempts to mollify the effect of the Federal Circuit's departure from the settled rule based on claim language by arguing that the decision was nonprecedential and that sources aside from the text of the claims are so compelling that they ought to override the claim text. This is nothing more than an assault on the rule that courts must presume that the terms in the claim mean what they say. The opposition's misguided reliance upon sources other than the claim text should not obscure the focus of the petition: the petition does not concern the erroneous application of fundamental claim construction rules; it concerns the failure to employ those rules at all.

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[1] The Rule 29.6 Statement appears at p. ii of the petition.

I. THE FEDERAL CIRCUIT DISTURBED SETTLED PRECEDENT BY SELECTIVELY DISREGARDING RULES OF CLAIM CONSTRUCTION.

Nowhere in the Federal Circuit's "Discussion" section of its opinion does the court discuss the actual text of the Enloe II and Enloe III patent claims that refers generically to "a pair of barrier cuffs." (JA114.) The opposition attempts to gloss over this unorthodox omission from the court's analysis by pointing out that the court reproduced claim 1 of the Enloe I patent in the "Background" section of its opinion. Opp. 11-12. But this is wholly beside the point because, as the Federal Circuit recognized in its opinion, Pet. App. 5a, Petitioner did not dispute that the claims of Enloe I were limited to fluid pervious flaps. A reading of the court's opinion reveals that the court neither grappled with the claim language of the Enloe II or Enloe III patents, nor gave any weight to the fact that the relevant language does not contain any limitation concerning the material from which the barrier cuffs (or flaps) are constructed. The opposition characterizes the court's opinion as focusing on "whether or not the word flaps (or its equivalent) . . . should be interpreted as being limited to fluid pervious ones." Opp. 12. Aside from the fact that the claims being constructed do not contain the word "flaps," (JA114, 130), the opposition mischaracterizes the court's analysis. The court did not delve into the etymology of the term "flaps" ("or its equivalent"), but instead considered other sources, wholly apart from the claim text, and decided that a fluid pervious limitation should be read into and curtail the broad claim text. Cf. *Johnson Worldwide Assocs., Inc.* v. *Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999) ("modifiers [are] not to be added to broad terms standing alone"). The opposition does not persuasively justify this unorthodox analysis.

Similarly unpersuasive is the opposition's attempt to explain the court's refusal to apply the doctrine of claim differentiation. The Respondents argue that the Federal Circuit concluded that Claim 26 of Enloe II is not "a claim to fluid pervious flaps." Opp. 15. The court did not draw such a conclusion, however, Pet. App. 8a, but instead stated that the doctrine did not apply because

> the doctrine of claim differentiation cannot in any event alter a definition that is otherwise clear from the claim language, the written description, and the prosecution history.

Id. Because the court below did not give consideration to the claim language, however, the assertion that the definition is "otherwise clear" as an excuse for not applying the doctrine rings hollow, and thus merely represents another rule of claim construction inappropriately set aside by the Federal Circuit.[2]

II. THE SPECIFICATION LANGUAGE DESCRIBES A PREFERRED EMBODIMENT THAT SHOULD NOT BE READ TO LIMIT THE GENERIC CLAIM LANGUAGE.

The plain meaning of the claim language is bolstered, not refuted, by the specification language. As recognized by the Federal Circuit, the written descriptions specifically state that the "'preferred material for the flaps . . . is a liquid pervious material.'" Pet. App. 6a (omission in original). This description of liquid pervious material as "preferred" necessarily implies what the claim language sets forth explicitly: a claim to generic barrier cuffs without limitation as to the material from which those barrier cuffs are constructed. Both logic and previous Federal Circuit caselaw dictate that a description identifying a device as "preferred" cannot limit the generic, claimed invention to that preferred device or embodiment. See, *e.g.*, *Karlin Tech. Inc.* v. *Surgical Dynamics, Inc.*, 177 F.3d 968, 973 (Fed. Cir. 1999); *Texas Instruments, Inc.* v. *United States Int'l Trade Comm'n*, 805 F.2d 1558, 1563 (Fed. Cir. 1986) ("This court has cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification."). But in this case the Federal Circuit arbitrarily refused to give this language its plain effect while seizing on other specification language stating that "'[t]he present application teaches an improved disposable garment which provides fluid pervious flaps.'" Pet. App. 6a (alteration in original). Rather than treating the claim language as paramount and reading the two specification statements so as to give the plain claim language its full and broad effect, the court read one of two specification statements to override both the claim language and the other specification statement. This, too, was contrary to previously settled law. See, *e.g.*, *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (courts are not to narrow broad claim language with limitations found in the specification unless the restriction is set forth "with reasonable clarity, deliberateness, and precision"); *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996); *Digital Biometrics, Inc.* v. *Identix, Inc.*, 149 F.3d 1335, 1344 (Fed. Cir. 1998).

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[2] As mentioned in the Petition, the Federal Circuit's claim construction rendered independent Claim 26 entirely superfluous. Pet. 17.

While the Federal Circuit ignored claim construction rules that highlight the importance and dominance of claim text, the court also misread the applicable prosecution history. The opposition, like the Federal Circuit, incorrectly concludes that the narrowing of Claim 1 in the Enloe I application to fluid pervious barrier cuffs (or flaps) necessarily means that Petitioner abandoned its claim of fluid impervious flaps for all time. Opp. 13. While the Federal Circuit has taken a similarly stunted approach to employing selective portions of prosecution history in another context, see *Festo Corp.* v. *Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000), *cert. granted*, 121 S. Ct. 2519 (2001), the prosecution history of Enloe II and Enloe III – the actual patents being construed – reveals that Enloe's broad invention was not, in fact, abandoned.

After Enloe provoked an interference with the Lawson patent – which indisputably claimed both fluid pervious and fluid impervious barrier cuffs – Enloe won the interference. (JA2466.) Respondents argue that Enloe's decision not to appeal from the Board of Patent Appeals and Interferences' denial of a motion to add claims directed to fluid impervious flaps constitutes an abandonment of such claims. Opp. 13. But Petitioner's position is that the Enloe II and Enloe III claims cover "barrier cuffs" generically – both fluid pervious and fluid impervious. "Barrier cuffs" as such are obviously shown in Enloe's specification, and by granting Enloe his victory in the interference, the Patent Office necessarily determined that Enloe was the first inventor of generic "barrier cuffs" and was entitled to the broad, generic claims of a pioneer. As a practical matter, Enloe did not need narrow claims directed only to fluid impervious barrier cuffs, because the generic claims that Enloe obtained after the interference properly cover all barrier cuffs, whether pervious or not.

In addition to reading the Board's denial opinion to say more than it does, Respondents attempt to explain how the Federal Circuit's opinion is not inconsistent with the claim construction rule recognized in *In re Spina*: "When interpretation is required of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent from which it was copied." 975 F.2d 854, 856 (Fed. Cir. 1992). While the opposition goes to great lengths attempting to explain how this rule does not support reading the text of the claim at issue as broadly as it is written, the Federal Circuit's opinion does not mention or consider this rule of construction at all.

Respondents point to the opinion in *Cultor Corp.* v. *A.E. Staley Manufacturing Co.*, 224 F.3d 1328 (Fed. Cir. 2000), to avoid the rule in *Spina*. Opp. 16-18. In *Cultor Corp.* the court held that the very specific disclaimer expressed in the patent's specification would not support a broad reading of the copied claim. *Cultor Corp.*, 224 F.3d at 1332. But a review of the disclaiming specification language in *Cultor Corp.* contrasts sharply with the Enloe specification, which describes liquid pervious flaps as a preferred embodiment (thus conveying the clear implication that the patent claim also encompasses impervious flaps). The *Cultor Corp.* specification stated as follows:

> "As used herein, the expression 'water-soluble polydextrose' . . . *specifically* refers to the water-soluble polydextrose prepared by melting and heating dextrose . . . in the presence of a catalytic amount . . . of citric acid."

Id. at 1330 (emphasis added). The patent claims copied, by contrast, "were not limited to polydextrose produced by using citric acid as a catalyst." *Id.* at 1332. The *Cultor Corp.* court simply did not ignore the specific and explicit disclaimer.

The *Cultor Corp.* opinion therefore is fully consistent with the *Spina* rule that the patent from which claims are copied is an important source upon which to draw when constructing the copied claims. See *Spina*, 975 F.2d at 856. Because some of Lawson's dependent claims (which are necessarily encompassed by the independent claim copied by Enloe, see Pet. 19) limit themselves to fluid impervious barrier cuffs, the copied claim that became a part of the Enloe II patent must also encompass the fluid impervious barrier cuffs. Thus, the "context of the patent from which [Claim 1 of the Enloe II patent] was copied," *Spina*, 975 F.2d at 856, confirms the plain and broad language of that claim's text.

III. THE UNPUBLISHED NATURE OF THE FEDERAL CIRCUIT'S OPINION DOES NOT CURE ITS HARMFUL EFFECT.

According to the opposition, even if the Federal Circuit's opinion does seriously flaunt previously settled rules of claim construction, this Court should ignore the issue. The opposition maintains that the decision will have no effect beyond this case because the Federal Circuit has declared that its opinion is not precedent. Opp. 9-11. The fact that the Federal Circuit decided to issue its unsettling opinion as an unpublished opinion, however, does nothing to ameliorate the perverse incentives the decision creates. To the contrary, the unpublished nature of the decision and its consequential lack of precedential authority, in combination with the exclusive jurisdiction granted to the Federal Circuit over appeals in cases related to patents, see 28 U.S.C. § 1295(a)(1), ossifies the ruling and its effects. As the opposition notes, litigants before the Federal Circuit are barred by Federal Circuit rule from citing unpublished rulings, see Fed. Cir. R. 47.6, thereby greatly reducing the likelihood that the Federal Circuit will reconsider its own erroneous ruling. This does not result, however, in the opinion having less importance in practice. Practitioners have ready access to the unpublished opinions through electronic means, and though the decision may not carry precedential weight in arguments before the Federal Circuit, the decision does constitute a precedent in the broader sense that what the court has done before, it likely will do again. Members of the patent bar drafting patent applications and advising clients will still be guided by the court's unsettling opinion. This opinion, as discussed in the Petition, Pet. 13-14, will affect the way that future patent applications will be drafted; it will drive information away from the public domain; and it will disrupt the expectations of parties to assignments, licensing agreements, and other transactions already made based on the previously settled rules of claim construction.

CONCLUSION

For the foregoing reasons and those stated in the petition, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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